
In The
UNITED STATES CIRCUIT COURT OF APPEALS

For The Ninth Circuit — Number 9693

THE L. McBRINE COMPANY, LIMITED,
Appellant,

vs.

SOL SILVERMAN and SAM SILVER-
MAN, co-partners doing business under the
name and style of BALKAN TRUNK &
SUIT CASE CO.,

Appellees.

THE L. McBRINE COMPANY, LIMITED,
Appellant,

vs.

HERMAN KOCH, doing business under the
name and style of H. KOCH & SONS, and
HAROLD M. KOCH, WILLIAM L.
KOCH, and REBECCA KOCH,

Appellees.

Consolidated

FILE

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BRIEF FOR APPELLANT

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Upon Appeals from the District Court of the United States
For the Northern District of California — Southern Division.



INDEX.

	Page
Introduction	1
Statement of the Case	3
Argument	5
Explanation of the Shoemaker Patent in Suit	5
History of the Development of the Patent in Suit and Prior Art Which Confronted Mr. Shoemaker	9
Advantages of the Patented Structure	15
The Law Applicable to Filling a Long Felt Need....	16
Commercial Success and Recognition of the Shoe- maker Invention	17
The Law Applicable to Commercial Success	19
The Infringing Structures Manufactured and Sold by the Defendants	20
Illustrations of the Infringing Structure and Ap- plication of Claims Thereto.....	Opposite Page 22
The Absurdities in the Defendants' Several The- ories of Non-Infringement	22
Comparative Illustration of Frame Mounting in Shoemaker Patent and Frame Mounting in Defen- dants' Structures	Opposite Page 26
Defendants' Extension or Auxiliary Frame Does Not Relieve Them of Infringement	29

Argument—Continued.

	Page
Law on the Subject of Invention and Novelty Over the Prior Art	35
The Presumptions Attaching to the Shoemaker Patent in Suit	36
The Defenses	38
The Alleged Maurice P. Koch Prior Invention, Prior Knowledge and Use and Sale.....	39
Illustration of Plaintiff's Suggestion as to the Assembled Relation of the Early Maurice P. Koch Fixtures	Opposite Page 44
Excerpts From the Testimony with Relation to the Alleged Early Koch Device, and Other Matters	47
The Alleged Early Koch Device of Exhibits K, L, and S, Even if Accepted, Does Not Anticipate Shoemaker's Relied Upon Claims	49
Law on the Quality of Proof and Evidence Required to Establish Prior Use, Prior Inventorship, etc.	50
Miscellaneous Prior Art Patents Relied on by the Defendants	53
The Storeh Patents	55
The Storeh Disclosures are not Anticipatory of the Relied Upon Claims of the Shoemaker Patent in Suit	64
Conclusion	66

Index of Authorities Relied on.

	Page
Bankers Utilities Co. vs. Pacific National Bank, 18 F. (2d) 16	20, 35, 65
Barbed Wire Patent Case, 143 U. S. 275.....	51
Butler vs. Burch Plow Co., 23 Fed. (2d) 15.....	36, 65
Carson vs. American Smelting & Refining Co., 4 F. (2d) 463, 468	52, 64
Claude Neon Electrical Products vs. Brilliant Tube Sign Co., 48 Fed. (2d) 176.....	37
Diamond Patent Co. vs. Carr, 217 Fed. 400.....	53
Eibel Process Co. vs. Minnesota & O. Paper Co., 261 U. S. 45	20
Esnault-Pelterie vs. United States, 27 U. S. P. Q. 272 (292)	61
Expanded Metal Co. vs. Bradford, 214 U. S. 366, 381	16
Ex Parte Grosselin-Commissioner's Decision 1901, 97 O. G. 2977	59
Farrington vs. Haywood, 35 Fed. (2d) 628.....	32
Forestek Plating & Mfg. Co. vs. Knapp-Monarch Co., 106 F. (2d) 554	16, 20
Jonas et al vs. Roberti, 7 Fed. (2d) 563.....	34
Lourie vs. Lenhart, 130 F. 122, 64 C. C. A. 456.....	32
Marsh vs. Seymour, 97 U. S. 348.....	38
Minerals Separation vs. Hyde, 242 U. S. 61.....	20
Minneapolis etc. Ry. Co. vs. Barnett & Record Co., 257 F. 302	38, 61
Paraffine Companies, Inc. vs. McEverlast, Inc. et al, 84 F. (2d) 335, 339	52

Authorities Relied on—*Continued.*

	Page
Parker vs. Stebler, 177 Fed. 210	53
Pyle Nat. Co. et al vs. Lewis, 92 F. (2d) 628, 630.....	16
Reinharts Inc. vs. Caterpillar Tractor Co., 85 Fed. (2d) 628	28, 38
Research Products Co. vs. Tretolite Co., 106 Fed. (2d) 530, 43 U. S. P. Q. 99	19
Sanitary Refrigerator Co. vs. Winters, 280 U. S. 30	29
Section 4886, Revised Statutes (U. S. C., Title 35, Sec- tion 31)	55
Section 4887, Revised Statutes (U. S. C., Title 35, Sec- tion 32)	56
Section 4923, Revised Statutes (U. S. C., Title 35, Sec- tion 72)	57
Smith Cannery Machines Co. vs. Seattle-Astoria Iron Works, 261 Fed. 85	33
Smith vs. Goodyear, 93 U. S. 486, 498.....	38
Temco Electric Motor Co. vs. Apco Mfg., 368 O. G. 259	34
The Electric Storage Battery Company vs. Shimadzu, 41 U. S. P. Q. 155	61
U. S. C., Title 28, Section 41.....	3
U. S. C., Title 28, Section 109.....	3
U. S. C., Title 28, Section 225.....	3
Warren Bros. Co. vs. City of Owosso, 166 Fed. 309	64
Webster's New International Dictionary.....	23, 28
Westinghouse vs. General Electric—District Court Case, 199 Fed. 907—affirmed by the Court of Ap- peals for the Second Circuit, 207 Fed. 75.....	60, 61

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BRIEF FOR APPELLANT*

Introduction.

The above designated causes of action were consolidated for trial in the District Court, pursuant to stipulation by

*(All italics ours unless otherwise specified. The parties will be referred to as in the Court below.)

the counsel for the respective parties, and with the approval of the Court. In each action the plaintiff is the same party, but the sets of defendants in the several actions are different. In each action the defendants are charged with infringement of United States Letters Patent No. 1,878,989 (R. Vol. II, p. 455) in the name of E. J. Shoemaker and issued, by virtue of an assignment, to The L. McBrine Company, Limited, of Kitchener, Ontario, Canada, on September 20, 1932. The L. McBrine Company, Limited, is the plaintiff-appellant. The patent in suit relates to improvements in hand luggage and the application for the Shoemaker patent was filed in the United States Patent Office on December 24, 1928.

In each action the defendants are engaged in the business of manufacturing and selling hand luggage including luggage which is equipped with fixtures therein for the convenient and effective packing, folding, and holding of garments, such as ladies' dresses, coats, and men's suits, entirely within the cover sections of the luggage cases. For the purposes of this litigation it has not been denied and it may be assumed that the accused structures of the defendants in the several actions are substantially the same mechanically. The defenses asserted by both sets of defendants are the same; so the issues involved in this appeal are equally applicable in both actions.

The consolidation of the several actions for purposes of appeal is authorized by virtue of an order of consolidation signed by the District Judge (R. p. 98) and also by an order of consolidation ordered by the Honorable Judge Wilbur on behalf of this Court (R. p. 447).

The present consolidated actions are the usual patent suits for infringement of a United States patent and as the defendants were citizens and residents of San Francisco, California, having regular and established places of business in said city, the actions were correctly brought in the

District Court in San Francisco, California, under the authority of the Act of March 3, 1911 (Judicial Code), by virtue of the provisions of U. S. C., Title 28, Section 41, and U. S. C., Title 28, Section 109. The final decrees of the District Court appear on R. pp. 90 and 92 and this appeal therefore reaches this Honorable Court under the authority of U. S. C., Title 28, Section 225, following due filing of notices of appeal (R. pp. 93 and 94) and the completion of other formalities.

Statement of the Case.

As this action is of the usual type involving patent infringement, the questions involved are first, as to whether or not the accused structures of the defendants are responsive to the relied upon claims of the Shoemaker patent in suit, and secondly, as to whether or not the relied upon claims of the patent in suit are valid.

The findings of fact and conclusions of law (R. pp. 86, 87, 88 and 89) are identical in each action and we will therefore reproduce only one set of findings and conclusions, the same reading as follows:

FINDINGS OF FACT.

1. That the parties are residents and citizens respectively as alleged in the complaint.
2. That plaintiff is the owner of Letters Patent in suit No. 1,878,989, dated September 20, 1932, issued upon an application filed on December 24, 1928.
3. That claims 4, 8, 10, 11, 12, 19, 23, 24, 26 and 27 of patent No. 1,878,989, are the claims relied upon by plaintiff.
4. That the invention of the patent in suit has had a great commercial success and has gone into wide and extensive use in the United States and elsewhere.

5. That the accused structures manufactured and sold by the defendants are fairly readable upon and respond to the relied upon claims of said patent in suit No. 1,878,989.
6. That the garment support shown in defendants' exhibits K, L and S was invented by Maurice Koch and was known and used by H. Koch & Sons in May, 1928, and luggage embodying fixtures similar to those in exhibits K, L and S were known and publicly sold in the summer of 1928 and thereafter.
7. The prior Koch luggage constitutes an anticipation of the relied upon claims of the Shoemaker patent in suit.

CONCLUSIONS OF LAW.

1. Claims 4, 8, 10, 11, 12, 19, 23, 24, 26 and 27 of the Shoemaker patent No. 1,878,989 are, and each of them is, invalid and void, for anticipation by and for lack of invention over the garment support invented by Maurice Koch and used by H. Koch & Sons in May, 1928.
2. If valid, the relied upon claims of the Shoemaker patent No. 1,878,989 would be infringed by the accused structures of the defendants.
3. Each side will bear its own costs.

The appellant challenges only the correctness of Findings Nos. 6 and 7 and Conclusion No. 1. We shall contend that application of the controlling law to the facts does not warrant said conclusion of law and this was, therefore, clearly erroneous.

The statement of points relied on on appeal are covered in R. pp. 99, 100, and 101. Points 1 to 7, inclusive, and No. 9 relate to Findings Nos. 6 and 7 and Conclusion 1, whereas points 10 and 11 relate to the admission in evidence of other material which was deemed by plaintiff to be objectionable.

ARGUMENT

Explanation of Shoemaker Patent in Suit.

The patent in suit (R. Vol. II, p. 455) is in evidence as plaintiff's Exhibit No. 1 and the assignment, showing title to the patent in suit in the plaintiff herein, is in evidence as plaintiff's Exhibit No. 2. The plaintiff is a corporation of Kitchener, Ontario, Canada, engaged in the business of manufacturing and selling articles of luggage, including the improved hand luggage cases covered by the Shoemaker patent in suit. In Canada the plaintiff corporation has exploited the invention in question for a number of years and since the date of the Shoemaker invention at least 150,000 luggage cases have been made and sold in Canada and have gone into extensive usage, embodying the features of the patent in suit (deposition of Shoemaker, R. p. 125).

The invention was introduced into the United States in the spring of 1929, at which time Mendel-Drucker of Cincinnati, Ohio, voluntarily asked for and obtained a license from the plaintiff herein (deposition of Shoemaker, R. pp. 123 and 124), and subsequently the plaintiff herein was voluntarily approached by the Wheary Trunk Co. and the Hartmann Trunk Company, both of Racine, Wisconsin, which companies were granted licenses and have exploited the invention in the United States (R. p. 124). Mr. A. A. Ritter, of Hartmann Trunk Company, in his deposition (R. p. 179), asserted that Hartmann Trunk Company has manufactured and sold over 70,000 luggage cases under its license, under the Shoemaker patent in suit (R. Vol. II, p. 455).

The structure of the patent in suit is of course fully disclosed in the patent copy, plaintiff's Exhibit 1. It is likewise more conveniently illustrated in the enlarged chart, plaintiff's Exhibit 9. With particular reference to the

chart, which shows Figs. 1, 3, and 4 of the drawings of the Shoemaker patent, it will be observed that the improved luggage case comprises a body portion A and a cover portion B hingedly connected to the body portion. The cover is adapted to be opened at right angles to the body section and is held in this position by suitable stays. In closed position the cover is held to the body by conventional latches, and the outer end of the body section is equipped with a handle whereby the luggage case may be readily carried in the usual manner. In its closed condition the end of the cover opposite the hinged end is at the top of the case and this should be borne in mind in later considering the novel arrangement of the fixture equipment within the case which permits supporting folded garments in a naturally draped relationship entirely within the cover section of the case.

The Shoemaker patent is what is known as "a combination patent" and the invention resides in the combination with certain portions of the luggage case, of a novel fixture device. This fixture or garment folding and compacting device includes a garment supporting member or frame C, and one or more removable bars or hangers D, detachably mounted on the inner end of the frame or supporting member C. In the claims these hangers or bars are referred to as "garment supporting means."

While the garment supporting member or frame C is depicted as being of H-formation, within the contemplation of the patent and the relied upon claims thereof, it may be of any suitable shape, and in commercial embodiments of this invention, the supporting member or frame C takes the form of a U-frame. In the figures of the Shoemaker patent drawings as shown in the chart, plaintiff's Exhibit 9, attention is directed to the fact that the inner end of the garment supporting member or frame C is hingedly or pivotally connected within the zone of the inner or hinged ex-

tremity of the cover B of the case. This supporting member or frame C is adapted to be swung from the vertical position entirely within the cover, depicted in Fig. 4, to a horizontal position substantially overlying the upper portion of the open body portion A of the luggage case, as in Fig. 1. The inner end of this supporting member or frame C carries yieldable bracket members G which are adapted to removably or detachably receive the ends of a garment hanger bar, or garment supporting means D. As shown in the copy of the Shoemaker patent (plaintiff's Exhibit 1), with particular reference to Fig. 11, the hanger or garment supporting means may take the form of a wire coat hanger 36 which is mounted on a peg 37 carried by the inner end of the supporting member or frame. In this connection the specification of the patent furthermore brings out that several hangers may be carried by the frame member if so desired to thereby accommodate a plurality of garments.

With the structure, as described and illustrated in the enlarged chart, garments are packed within the improved hand luggage case and are folded and compacted within the cover section of the case in the following manner: If a lady's dress, for instance, is to be packed, the dress is first primarily folded and the detached hanger bar D is positioned through the fold of the garment as in Fig. 3. The hanger bar is then moved over the open face of the body section of the case and is inserted in the brackets G at the inner end of the supporting member or frame C, but the dress, being only once folded, extends forwardly a substantial distance beyond and over the front edge of the body section A of the case. To secondarily fold the garment and to confine it within the cover of the luggage case it is only necessary to flip the supporting member or frame C from its horizontal position to its vertical position within the cover of the case, as in Fig. 4. The extending portion of

the garment will then drape over the so-called folding edge E of the frame member C in the manner shown, with the secondary fold being then completed in the garment. It should be observed that during the manipulation of the frame or supporting member C from its horizontal position to its vertical position *three things are automatically and simultaneously accomplished*. The entire fixture and all of the mechanism is housed and positioned within only the cover section of the case. The garment is confined and located in folded condition *entirely* within the cover section of the case. And, the same movement of the frame which serves to position the mechanism and garment also automatically and simultaneously serves to impart the secondary or additional fold in the garment.

The luggage case is provided with means F for retaining the supporting member in packed position in the cover of the case. These means, in the patent, take the form of flexible retaining bands, although in commercial exemplifications of the invention they may be in the form of latches, curtains, or other equivalent means.

The simple fixture above described and the easy manipulation thereof serves to locate and retain full length garments, such as dresses and the like, entirely within the cover section of the wardrobe case. This is of considerable advantage because the entire body section of the case is then left free for the packing of miscellaneous articles of wearing apparel and traveling paraphernalia. By virtue of the swing frame or fixture ready access may always be had to the body section of the case, without in any way disturbing or mussing the garments compacted and held by the folding fixture.

History of the Development of the Patent in Suit and Prior Art Which Confronted Mr. Shoemaker.

Not being able to produce one or two examples of really pertinent prior art the defendants assaulted the patent in suit by putting into evidence an extremely large and burdensome number of prior patents, all of more or less questionable value. As a matter of fact, the record now includes over twenty-four patents of assorted and miscellaneous types. Not one of these patents suggests or discloses a novel combination in any way similar to that of the Shoemaker patent. The prior art patents relied on by the defendants may be segregated into various groups. For instance, there is that group of prior patents which relates to wardrobe trunks or the like, as exemplified by the Von Ohlen patent No. 906,153 (R. Vol. II, p. 624), the Langmuir patent No. 1,698,848 (R. Vol. II, p. 651), and others. We frankly admit that wardrobe trunks, containing hanger means for garments, were old in the art prior to Mr. Shoemaker's development. These wardrobe trunk patents did not in any way assist Mr. Shoemaker with his problems. In the wardrobe trunk art there is no thought of packing dresses and like garments entirely within the cover of a case and the packing is not accomplished in such a manner as to permit compound folding and non-shiftable draping of the garments relative to the normal position in which a suitcase is carried. The hanging devices in wardrobe trunks do not provide for compound folding and certainly do not provide for a mechanism which simultaneously produces compound folds in a garment while storing the fixture and garment solely within the cover section of a container.

Another class of the prior art patents relates to boxes for garment display and for burial shrouds as exemplified by Boden No. 935,958 (R. Vol. II, p. 586) and others. This

type of display box does not have a body section with a cover hingedly associated therewith and it does not so house long garments as to give access to the body section of the box for other articles. These devices do not include a frame with a hanger bar on the frame providing for primary and secondary folds in the garments and simultaneous transposition of the supported garments into another section of the container.

The Burchess patent No. 1,081,014 (R. Vol. II, p. 549) represents a suitcase having a portfolio and secret compartments in its cover section. This device cannot house and compactly fold full length dresses and is of no value whatsoever in connection with the Shoemaker problem.

Another group of patents relates to paste board tailor's boxes as represented by the patents to O'Donnell No. 1,094,087 (R. Vol. II, p. 631), Simmons No. 1,208,221 (R. Vol. II, p. 592), and Lengsfeld Re 17,177 (R. Vol. II, p. 606). These devices fail to disclose anything in the way of removable hangers or bars and packing of the same is not convenient nor expeditious. These devices may be used once but are not practical for frequent and continued usage. The garments in these boxes are housed in the body sections of the boxes and the boxes do not have hinged covers.

Another group of patents discloses various miscellaneous types of suitcases or traveling bags equipped with complicated or inadequate garment retainers. This group of patents includes the following: O'Niell No. 1,150,058 (R. Vol. II, p. 635), Fasel and Garland No. 1,382,964 (R. Vol. II, p. 558), Winship No. 1,728,223 (R. Vol. II, p. 568), La-Prade No. 1,742,656 (R. Vol. II, p. 656), Storch United States and Austrian (R. Vol. II, pp. 661 and 539), Wheary No. 1,799,877 (R. Vol. II, p. 576), and Pownall No. 1,810,786 (R. Vol. II, p. 666). In all instances the devices in this group of patents have structures which are either inadequate or too complicated for practical usage and in reality

disclose that the Shoemaker device is a decided improvement and is in fact a meritorious invention. The Winship patent, for instance, was one of the earliest wardrobe case devices which went into usage for a short period of years. This Winship arrangement merely permitted a dress to be draped over an upper bar and required that the lower portion of the dress hang into and be housed in a compartment in the body section of a wardrobe case. The Wheary patent and the patent to Fasel and Garland picture modifications or alternative arrangements for accomplishing about the same purpose. The Storch patents illustrate absurdities in the way of anything which might be practical.

The last group of prior art patents are those which relate to loose wrapping devices or frames and are exemplified by Steuwer No. 1,641,705 (R. Vol. II, p. 564), Hopkins No. 1,861,274 (R. Vol. II, p. 610), Hamlin No. 1,869,418 (R. Vol. II, p. 673), and others. These frames or loose wrapping devices are not in any way integral with a suitcase and are awkward, bulky, and heavy. They must be separately loaded with a garment before being independently applied to a container.

In analyzing these groups of prior art patents we must bear in mind that Mr. Shoemaker was concerned with luggage wherein he sought to accomplish several specific and desirable ends. Mr. Shoemaker deemed it desirable and proper to have the garment folding and carrying fixture an *integral and permanent part of a luggage case*. He furthermore believed that the packing of full length garments should be accomplished in a manner so as to entirely house these garments and the holding and folding fixtures within the cover of a luggage case, so as to leave the body section of the case entirely free and accessible, and Mr. Shoemaker furthermore believed that these results should be accomplished in a luggage case of limited and reduced dimensions.

On the latter point we wish to bring out that the present invention is concerned with a piece of *hand luggage* which must of necessity be light and compact and susceptible of easy handling and it must be of such dimensions that it can be transported in the usual manner and stored under a Pullman seat during train travel. The fixtures must not project beyond the outlines of the case or difficulty will be encountered in packing the luggage case in the limited confines of a Pullman berth. All of these particular problems were solved in a most practical manner by Mr. Shoemaker and it can be said with assurance that very few of the twenty-four or more prior art patents offered in evidence by the defendants made any practical contributions to the hand luggage field or in any way solved the particular problems. We dare say, that outside of the wardrobe trunk patents, and possibly one or two of the paste board tailor's box patents not more than one or two of the structures of the suitcase patents ever went into practical usage, and so far as the record in this case discloses, only the structures of Winship and Fasel and Garland had any success commercially, and these structures were relatively short lived, and by admission of witnesses, including those of the defendants, have been supplanted today by structures following the teachings of the patent in suit.

In his deposition (R. p. 116) the patentee, Mr. Shoemaker stated,

“and I tried to develop a case which would carry clothing in a folded or hanging position in as small a dimension as possible.”

He was only familiar with the Winship type of case and fixture and on R. p. 118 in his testimony stated,

“I felt, in the first place, that in order to hang garments of any length, or I should say of considerable length, it required a large case, and I saw the desirability of producing something that was more

compact." * * * "First of all, I wanted to produce a case that was considerably smaller than that which was then on the market but with the same, or if possible, with greater capacity. I wanted the garments to be contained entirely in the cover and to be hung on the hanger or rack in such a way that they were carried in proper relationship to the carrying position of the case."

We further quote from the patentee's deposition on R. p. 122 as follows:

"The earlier arrangement, having a bar near the free end of the cover only, draped the garments from the bar vertically down into the so-called body of the case which was needed in order to accommodate the full length. A dress of 52" in length, for instance, required in the old construction (referring to the Winship type of case) a case at least 18" wide and a body 8" deep, whereas my invention allowed the same length to be packed in a case only 15" wide and without the use of a body section."

From this quotation it will be seen that in the earlier structures of the Winship type the height of the cover section had to be at least 18" and in addition thereto 8" of depth of the body section were required to house a 52" dress. With the Shoemaker invention the same length dress could be packed in a case which had a cover dimension or height of only 15"—this is a saving of 11" and is very important in effecting a compact luggage case of relatively modest dimensions.

There is a decided advantage in having the fixture equipped with a removable rod or hanger device. Mr. Shoemaker mentioned this advantage in his deposition on R. p. 121 and said:

"By having the rod removable the dress can be laid out on a bed or table, the rod inserted and the primary fold accomplished as shown in Fig. 3. The rod is then returned to its position at the base of the rack 12, while it is in horizontal position over the body of the case."

There is also a decided advantage in having the fixture arranged so as to be housed completely within the cover of a case and Mr. Shoemaker explained this on R. p. 122 by saying,

“It concentrates the mechanical parts of the hanging arrangement in one location.”

Obviously this concentration of the parts of the fixture leaves all of the rest of the cover clear and free for the accommodation of garments in conserved space. On cross-examination (R. p. 140) the witness stated,

“Well, the invention is for the purpose of carrying garments of any length and description, as is commonly done by people carrying luggage.”

On R. p. 141, in comparing his structure with that of Winship, Mr. Shoemaker stated,

“One of the objects of my invention was to reduce the size of the case, still retaining the hanging capacity.”

Mr. A. A. Ritter, connected with a licensee under the Shoemaker patent, which licensee has been engaged in substantial exploitation of the invention within the United States, testified in his deposition (R. p. 178) that the Shoemaker invention was very desirable and

“It allows us to bring them (meaning dimensions of a case) down to a reasonable dimension and easy to carry and small in size, which is quite necessary, particularly so in women’s luggage.”

In comparing cases of the Winship type with present luggage cases embodying the Shoemaker invention Mr. Ritter said (R. p. 188),

“The case (Winship type) would necessarily have to be made of an extreme width that might be very inconvenient for a woman to carry.”

This was with reference to accommodating a garment of the length which the Hartman “Skyrobe,” equipped with a fixture embodying the Shoemaker invention, will carry.

Advantages of the Patented Structure.

Some of the previous discussions in connection with other topics have incidentally set forth the advantages of the structures embodying the Shoemaker invention. Mr. Shoemaker's deposition sets forth very clearly the points he had in mind in developing the invention, and the deposition of Mr. A. A. Ritter develops the advantages of the structure from a commercial standpoint and emphasizes the desirability of the Shoemaker features in present day wardrobe hand luggage. The advantages of the patented structure must be obvious and the patentee has been paid the compliment of having his development substantially copied by the defendants in this litigation. Obviously these defendants find the structure in question to be extremely desirable, or they would not have appropriated the precise features of the patent in suit.

Mr. Roemer in his testimony (R. p. 204 et seq.) clearly points out some of the desirable features found in luggage cases incorporating the structure of the patent in suit.

It must be recognized that at the time of Mr. Shoemaker's invention wardrobe hand luggage then available was most inadequate and makeshift and unsuited for practical purposes. Immediately following Mr. Shoemaker's development the idea "caught on" and spread like wild fire and luggage cases embodying the invention have been sold in Canada and the United States since 1929 in tremendous numbers. This invention has supplanted all other devices in its field and most obviously has filled a long felt need. Some of defendants' witnesses admitted that the earlier structures cannot be sold today and Mr. Maurice Koch admitted that his alleged 1928 development is "an entirely different fixture. It operates differently from this" (R. p. 334). Witnesses for the defendants further admitted that

earlier forms of luggage cases which they had formerly exploited had been superseded by the present complained of types of luggage cases and that the former types of luggage cases would not sell today. (See testimony of Albert Kantrow, R. p. 339.)

The Law Applicable to Filling a Long Felt Want.

The foregoing shows that the luggage industry had long sought an answer as to how to effectively house within the cover section of a luggage case a full length garment such as a dress, maintaining the garment in a proper condition with compound folds therein, without subjecting the garment to displacement, dishevelment, or creasing. The problem was solved by Mr. Shoemaker. Now, by the exercise of hind sight the solution seems simple, but this is a tribute to Mr. Shoemaker's creative ability.

The Ninth Circuit Court of Appeals has commented on similar situations. In *Pyle Nat. Co. et al vs. Lewis*, 92 F. (2d) 628, 630, the Court said,

"It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored."

To the same extent are:

Expanded Metal Co. vs. Bradford, 214 U. S. 366, 381;

Forestek Plating & Mfg. Co. vs. Knapp-Monarch Co., 106 F. (2d) 554 (C. C. A. 6, Sept. 18, 1939).

Commercial Success and Recognition of the Shoemaker Invention.

It is difficult to conceive of a case wherein the patent in suit has received a higher degree of recognition and has had attached thereto a more persuasive showing of commercial success than in the instant litigation. This fact was recognized by the District Judge who specifically found:

“That the invention of the patent in suit has had a great commercial success and has gone into wide and extensive use in the United States and elsewhere” (Finding 4, R. p. 86).

This finding was adequately supported by the evidence and can not be assaulted nor overthrown. The Shoemaker invention had its inception in the latter part of the year 1928. Early in 1929 exploitation of the same was commenced in Canada with considerable success and in the early part of 1929 the invention was introduced into the United States, at which time Mendel-Drucker Co. of Cincinnati, Ohio, voluntarily requested and obtained a license under the patent in suit. This was followed a few years later by a license issued to the Wheary Trunk Co. of Racine, Wisconsin, and the Hartmann Trunk Company of Racine, Wisconsin, voluntarily negotiated for and secured a license effective as of January 1, 1935. All of these companies have been operating in the United States under licenses since the grant of the patent and articles of hand luggage embodying the invention have been sold in vast numbers from coast to coast.

Coupled with the normal presumption of validity which attaches to the issuance of a patent we have this widespread recognition of the patent in suit, plus the existing licenses which have been granted to the foremost companies in this industry in the United States. Recently the patent owners granted a license to Vogue Luggage Co. of San Francisco, California, and this company through a consent decree, offered in evidence as plaintiff's Exhibit 12, acknowledged

validity and infringement of the Shoemaker patent in suit. The present defendants have paid the inventor the compliment of appropriating his novel combination and these defendants are exploiting the invention with considerable success and, in fact, their present accused products have supplanted prior luggage case structures which they manufactured and sold before becoming acquainted with the novel Shoemaker luggage case structure.

As to the extent of exploitation of the invention in Canada, Mr. Shoemaker in his deposition stated on R. p. 125,

“Well, since I invented it we have made at least 150,000.” * * * “and they have been sold in Canada.” * * * “used quite extensively.”

The United States patent of Mr. Shoemaker has been of considerable value to his company and Mr. Shoemaker furthermore stated on R. p. 126 in regard to what the McBrine Co. received for license rights,

“We receive money, and other considerations in the form of exchange of ideas from each of them.”

On page 126 it is brought out that the United States patent has been of value to the McBrine Co. in permitting an exchange of ideas and closer working relationship with certain mentioned leading United States companies and the patent has furthermore given the owners added prestige in the industry.

The deposition of Mr. Shoemaker on R. p. 124 brings out the grant of licenses to the United States companies previously mentioned. Luggage cases made by these companies in the United States

“are sold practically everywhere in the United States because these companies operate nationally and I have seen cases made by them in stores in various parts of the United States” (Shoemaker deposition R. p. 125).

Mr. A. A. Ritter of the Hartmann Trunk Company, in his deposition (R. p. 170 et seq.) brought out the facts leading up to the license obtained by said company under the Shoemaker patent in suit. By reference to plaintiff's Exhibit 3 numerous illustrations and representations of articles of hand luggage made and sold by this licensee will appear. This licensee numbers among its dealers some of the largest and most representative stores in the United States including Saks-Fifth Avenue of New York City; Filene's of Boston; John Wannemaker of Philadelphia; Marshall Field of Chicago; Neiman-Marcus of Dallas, Texas; Bullocks and I. Magnin & Co. on the Pacific Coast (Ritter deposition R. p. 173). The same witness, on R. p. 179, brought out that to date Hartmann Trunk Company has manufactured over 1,200 men's cases and approximately 69,000 ladies' cases embodying the features of the Shoemaker patent in suit.

The Law Applicable to Commercial Success.

One of the best statements on this phase of the law is found in the very recent Ninth Circuit Court of Appeals case of *Research Products Co. vs. Tretolite Co.*, decided September 7, 1939, 106 Fed. (2d) 530, 43 U. S. P. Q. 99, wherein Judge Wilbur, speaking for the Court, said,

“So great and immediate a success speaks strongly of invention, adding to the strong presumption of invention, raised by the issuance of the patent.”

The Shoemaker invention filled a long felt need—that is most certainly evidence of invention. Shoemaker's fixture-equipped hand luggage has been copied and imitated. The public has paid the tribute of enormous purchases and leading companies in the industry have secured licenses. These facts even more clearly evidence the fact that the creation of the Shoemaker hand luggage case was invention. On this subject attention is respectfully directed to the following additional citations:

Forestek Plating & Mfg. Co. vs. Knapp-Monarch Co., 106 F. (2d) 554 (C. C. A. 6);
Bankers Utilities Co. vs. Pacific National Bank, 18 F. (2d) 16 (C. C. A. 9);
Minerals Separation vs. Hyde, 242 U. S. 61;
Eibel Process Co. vs. Minnesota & O. Paper Co., 261 U. S. 45.

The Infringing Structures Manufactured and Sold by the Defendants.

As this litigation involves infringement by two sets of defendants, consolidated for purposes of trial, technically perhaps the structures of both sets of defendants should be discussed. The alleged infringing luggage cases manufactured and sold by the defendants Herman Koch et al are shown by the physical exhibit, plaintiff's Exhibit 7, as well as the photographic exhibits, plaintiff's Exhibits 7A and 7B (R. Vol. II, pp. 468 and 469). Likewise the structure manufactured and sold by the defendants Silverman et al (Balkan) is exemplified by the physical exhibit, plaintiff's Exhibit 8, as well as by the photographs, plaintiff's Exhibits 8A and 8B (R. Vol. II, pp. 470 and 471). These structures were, admittedly, through stipulations and answers to interrogatories, manufactured and sold by the various defendants herein within six years prior to the filing of the bills of complaint. The luggage cases of the Silvermans et al were equipped with a "Rite-way" fixture manufactured by Milwaukee Stamping Company but more recently the defendants Silverman et al have adopted a fixture in their luggage cases manufactured by Presto Lock Corporation. This later fixture is included in one of defendants' exhibits bearing exhibit number T. By admission the luggage case structure of Exhibit T and the fixture therein is to all practical intents and purposes the same structurally as the structure in plaintiff's Exhibit 8. Inasmuch as the struc-

tures of both sets of defendants are the same in the relationship of component parts and operation, we will only here compare the Koch et al case with the relied upon claims of the patent in suit for the purpose of showing prima facie infringement. In the depositions taken on behalf of the plaintiff the witness Ritter discussed the accused structures and showed how they responded to the claims of the patent in suit and during the trial Mr. Roemer also applied certain of the claims of the patent in suit to the structures of both sets of defendants.

Opposite page 22 of this brief immediately following this discussion, we have reproduced showings of the Koch et al luggage case in evidence as plaintiff's Exhibit 7 and have graphically applied the elements of a number of the claims to this piece of hand luggage. This will disclose rather clearly the fact that the structures of the defendants freely respond to the relied upon claims of the patent in suit. This showing, coupled with the testimony in the case, establishes without any doubt, the fact that the accused structures are clearly within the contemplation of the relied upon claims of the Shoemaker patent.

At this point it may be stated that the plaintiff is relying on the following claims in the Shoemaker patent in suit, viz: Nos. 4, 8, 10, 11, 12, 19, 23, 24, 26 and 27. The structures of both defendants are alleged to infringe all of these claims.

It may also be helpful to the Court to refer to plaintiff's Bill of Particulars (R. pp. 30 to 39 inclusive) wherein the plaintiff, at the insistence of the defendants Silverman et al, made a detailed application of the patent claims to the accused structure.

On the question of prima facie infringement we also desire to emphasize the findings and conclusions of law of the District Court. In Finding No. 5 (R. p. 87) the District Court found:

“That the accused structures manufactured and sold by the defendants are fairly readable upon and respond to the relied upon claims of said patent in suit No. 1,878,989.”

As a conclusion of law it was held in Conclusion No. 2 (R. p. 87):

“If valid, the relied upon claims of the Shoemaker patent No. 1,878,989 would be infringed by the accused structures of the defendants.”

Under Rule 52 of the Federal Rules of Civil Procedure findings of fact shall not be set aside unless clearly erroneous. The evidence clearly sustains the above quoted finding and conclusion and the same must stand.

The Absurdities in the Defendants' Several Theories of Non-Infringement.

The defendants in the instant litigation have appropriated the structural features and spirit of the Shoemaker patent in suit but in the Court below, as an excuse for their actions, urged several unique and unsupported theories as to why their accused structures are not within the relied upon claims of the Shoemaker patent. We will show that there is no basis in law or in fact for the positions taken by the defendants in these particulars.

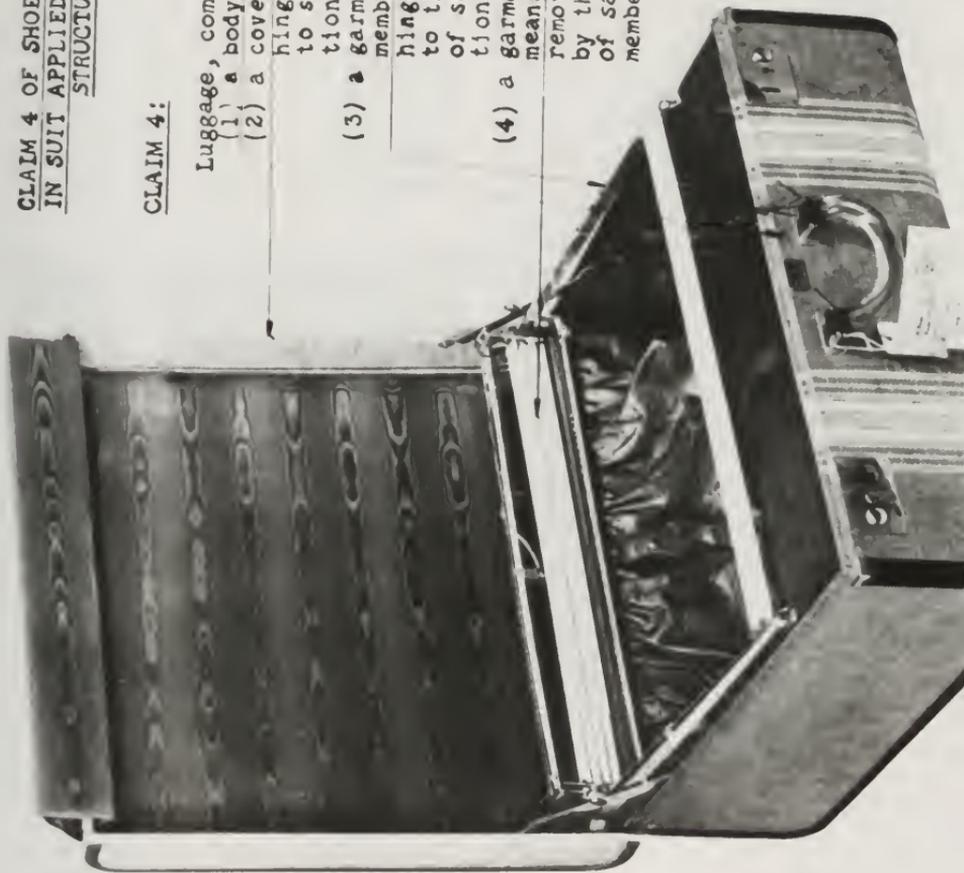
What is or is not the “hinged side” of the cover of a luggage case: In view of the fact that a number of the relied upon claims of the Shoemaker patent in suit define the garment supporting member or frame as being hingedly connected to the *hinged side* of the cover portion of the luggage, it becomes important to ascertain what in fact constitutes a hinged connection as between a garment supporting member or frame in a piece of hand luggage, and the hinged side of the cover of the luggage. The defendants urged the very narrow and unwarranted theory that the “*hinged side*” of the cover, as contemplated by Shoemaker

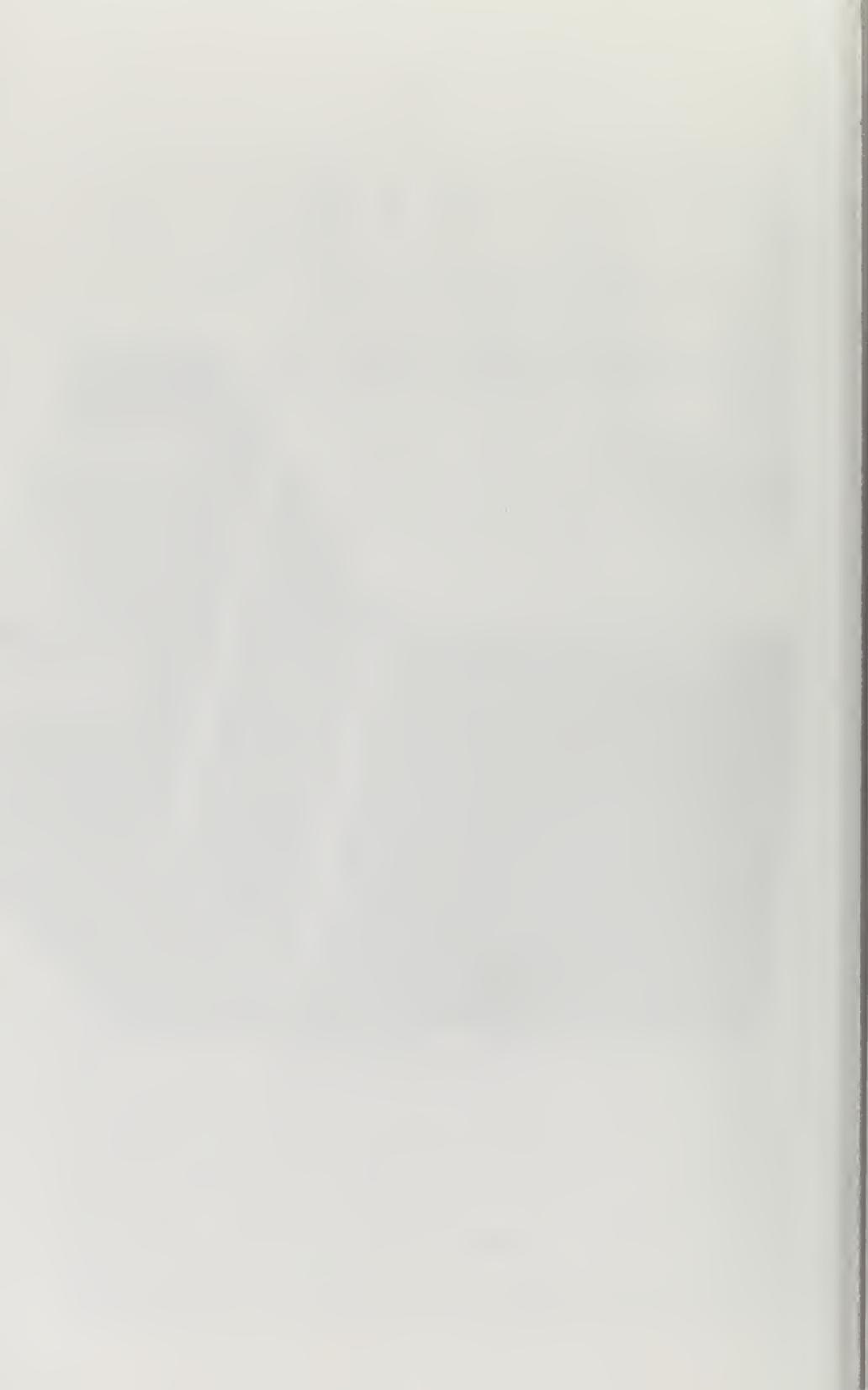
CLAIM 4 OF SHOEMAKER PATENT
IN SUIT APPLIED TO DEFENDANTS'
STRUCTURES.

CLAIM 4:

Luggage, comprising

- (1) a body portion (A);
- (2) a cover portion (B) hingedly connected to said body portion;
- (3) a garment supporting member (C) hingedly connected to the hinged side of said cover portion and
- (4) a garment supporting means (D) removably carried by the hinged side of said supporting member.





ELEMENTS FROM OTHER
RELIED ON CLAIMS OF
PATENT IN SUIT AP-
PLIED TO DEFENDANTS'
STRUCTURES

Claims
8, 10, 11

A garment supporting means, (D), on which a garment may be primarily folded,
A folding edge, (E) formed on the free side of said supporting member, on which said garments may be secondarily folded.

Means (F) for retaining said supporting member in packed position in said cover with said garments supported in parallel relationship to the normal carrying position of said luggage.

Means (G) carried by said supporting member for removably attaching said garment supporting means adjacent said hinged side of said cover



19, 23, 24 portion.

means a specific rear or inner panel of the cover—in other words the particular rear panel which is directly fastened by hinged means to the body section of the case.

We assert that this construction of the claims does violence to their intended meaning and to the ordinary theories and principles of patent law concerning mechanical equivalency and interpretation of phraseology. The debate seems to be over the construction of two words, namely, “side” and “connection.” To ascertain what is implied by these words appearing in the Shoemaker claims it would seem proper to consult two sources—the dictionary and the Shoemaker patent specification. We logically contend, of course, that in the claims the “hinged side of the cover” is used as a relative term to designate that zone of the cover which is adjacent the hinged connection with the body section of the case as distinguished from the opposite free or swingable end or side of the cover. The definition of “side” found in *Webster’s New International Dictionary—Second Edition*, exactly coincides with our interpretation of this term as in Webster’s dictionary the following definitions of the word “side” appear:

“a place, space, or direction with respect to a center or a line of division, as of an aisle, river, or street; as altars on either *side*; put to one side.”

“a part located in a particular direction from a center or line of division; as one *side* of a room or city.”

These definitions correspond precisely with Mr. Roemer’s interpretation as to what was meant by the expression “hinged side of the cover.” We respectfully direct the Court’s attention to the following excerpts from the testimony of Mr. Roemer:

“I don’t think the hinged side of the cover is in any way limited by the patent or by the general meaning of the term ‘hinged side’ to any specific panel or part of the case.

“Q. The term ‘hinged side of the cover’ doesn’t in your estimation refer to any specific wall of the cover?”

“A. Indeed it doesn’t. It just refers to one general side of the cover.

“Q. Is it a relative term distinguishing one particular end of the cover as with relation to the free end of the cover?”

“A. Yes, it is. It is used to designate the general position within the cover.

“Q. I would like to read a portion of Paragraph 3 on Page 1 of the Shoemaker specification and would ask whether this statement bears out your theory: ‘A further object of my invention is to provide a supporting member which is hingedly mounted relative to the hinged side of the cover portion of the luggage.’”

“A. ‘Relative to’ in that sense means in the neighborhood of.

“Q. Would you say the patentee intended to be restricted to any particular wall of the cover?”

“A. No. As a matter of fact, I am quite sure he did not” (R. pp. 226 and 227).

Again on R. p. 252 Mr. Roemer very clearly stated,

“By ‘hinged side of the cover’ I mean, and I think the Shoemaker patent clearly means, that portion of the cover which is near the hinge as distinguished from that portion of the cover which is free.”

Mr. Roemer, in the later discussion, explained his theory of the “hinged side of the cover” and it is interesting to note that his theories correspond almost precisely with the before quoted definitions of “side” from Webster’s dictionary. On cross-examination (R. p. 260) he was asked:

“Q. Therefore you base your definition in that case on the definition of the side of the cover as if the cover was split in half and entirely across, and in one half of it, the lower half, is one side and the upper half is the other side; is that correct, is that your definition that you have in mind?”

And the witness' answer was as follows:

“A. Yes. Not necessary to split the cover in half, but just to say the hinged side is one side and the free side is the other side.

“Q. Well, which side is the hinged side?

“A. The hinged side is that side adjacent to which the cover is hinged to the body member.”

By reference to the specification and claims of the Shoemaker patent in suit it will become evident that the patentee did not intend to limit his invention to the hinging of his frame to a specific wall or panel of the cover. It was simply the patentee's theory that the hinge or pivot connection for the frame should be a connection with the cover in the zone of the hinged area or end portion of the cover. This was for the purpose of locating and confining the movable parts and associated elements within a particular portion of the cover so as to make use of the remaining length of the cover for packing purposes. This theory is absolutely borne out by the statement on Page 1 of Shoemaker's specification, lines 11, 12, 13 and 14, reading as follows:

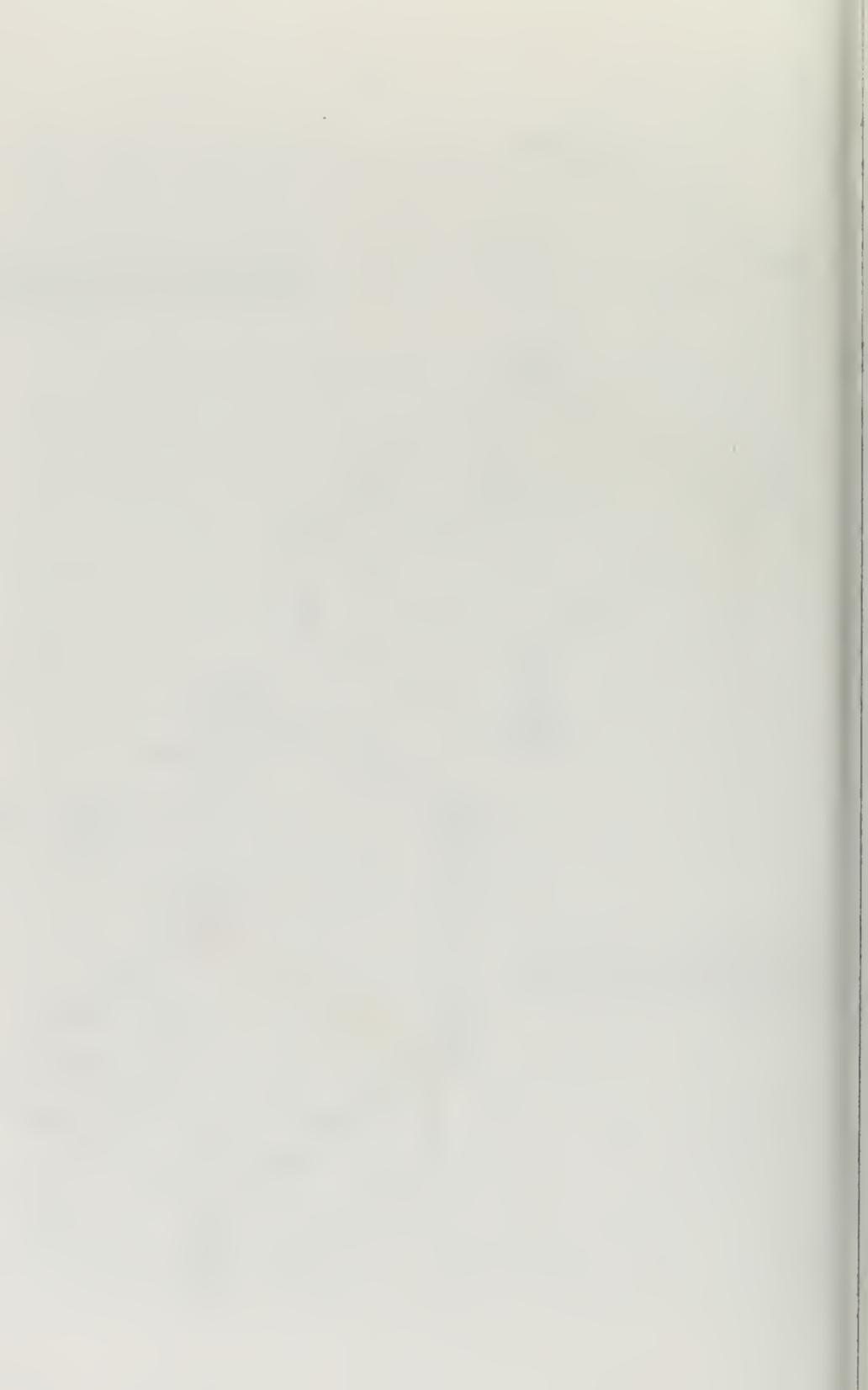
“A further object of my invention is to provide a supporting member which is hingedly mounted *relative to the hinged side* of the cover portion of the luggage * * *”

On Page 2, lines 29 to 33, the patentee states,

“I do not wish to be limited in the means or manner whereby the base portion 16 of the supporting member 12 is hingedly or pivotally connected in relationship to the cover 10.”

By this statement it is very obvious that the patentee felt that he was entitled to the usual range of equivalency.

The defendants, in their attempt to read an unwarranted limitation into the relied upon claims of the Shoemaker patent, have in this respect, entirely overlooked relied upon claim 27 which does not define the mounting of the frame in the manner referred to in connection with the other claims.



drawings it will appear that the frame member is designated 12 and the side extremities of its inner end carry attached and outwardly projecting pins 15. The projecting ends of these pins pass into openings in certain ears or brackets 14, which ears or brackets are anchored to the bottom or inner panel of the luggage case cover. We respectfully direct the Court's attention to Fig 1 appearing opposite page 26 of this brief which represents the showing of Fig. 1 in the Shoemaker patent. For convenience the bottom or inner panel of the cover has been colored yellow and the ears or brackets 14 mounted on this panel are colored red. This will disclose the fact that the frame 12 is not in fact hingedly connected *directly* to the yellow panel A but is connected to this panel through the medium of the red ears or lugs 14 which are secured on the panel A, toward the side edges thereof. Now, let us assume that these red ears or lugs 14 are moved to the extreme side edges of the panel A, in which case they became merged with the lower portions of the side walls B of the cover. In that case the ears or lugs 14 could be dispensed with and the hinge pins 15 could be attached directly to the lower side wall portions B of the cover. This is precisely the arrangement utilized by the defendants in this litigation as disclosed in Fig. 2 of the drawings opposite page 26 of this brief. It is simply an equivalent arrangement wherein those portions of the lower side walls of the cover which are colored red serve as the red ears or lugs 14 in Fig. 1 (the specific Shoemaker disclosure).

In Shoemaker's specific illustration the inner end of the frame 12 is connected to the hinged panel A through the medium of upstanding lugs or ears 14. In the structure of the defendants, the inner ends of the frame 12 are hingedly connected to the same panel A through the medium of the portions 14 of the side walls of the cover which serve exactly the same function as Shoemaker's lugs or

ears 14. Hence, just as in the Shoemaker disclosure, the defendants' frames are hingedly mounted on the hinged side of the cover of the case and this is absolutely a fact even if the most narrow interpretation is given to Shoemaker's claims. It seems to us that there is literal fidelity to the language of the claims; and there is certainly the most obvious equivalency.

Before leaving this subject we wish to point out the fact that the claims under consideration require that the garment supporting member or frame be *connected* to the hinged side of the cover portion. *Webster's New International Dictionary* defines "connect" as follows:

"to join or fasten together, as by something intervening."

In the specific Shoemaker showing the frame is fastened to a certain panel of the cover through the intervening lugs or ears 14. In the defendants' structures the garment frame is joined or fastened to the same panel of the cover through the intervening areas 14 of the side walls B of the cover. Under any interpretation there can be no question but what the defendants' structures are fully responsive to the claims in suit, either on the theory of mechanical equivalency or on an absolute literal and most limited reading of the claims.

A relatively recent case decided by the Ninth Circuit Court of Appeals merits consideration in its applicability to the present questions. Reference is made to *Reinharts Inc. vs. Caterpillar Tractor Co.*, 85 Fed. (2d) 628, wherein the Court said on pages 635 and 636:

"Appellant contends that, since each of the patents in suit is for a mere improvement, the claims thereof 'must be strictly limited to substantially the identical construction described in the specification.' That is not the law. It is the claims of a patent, not its specifications, which measure the invention."

“ ‘the monopoly granted by the patent is not to be limited to the identical devices exhibited in the drawings or prescribed in the specifications.’ ”

“but it is not true that only primary patents are entitled to invoke the doctrine of equivalents. *Continental Paper Bag Co. vs. Eastern Paper Bag Co.*, supra, 210 U. S. 405, at page 415, 28 S. Ct. 748, 52 L. Ed. 1122. A patent for a meritorious improvement in an old art is entitled to liberal treatment. *Eibel Process Co. vs. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 63, 43 S. Ct. 322, 67 L. Ed. 523. The *Turnbull*, *Holt*, *Wickersham* and *Whitacre* inventions, though not basic or primary, are substantial and important and are, therefore, entitled to a fair range of equivalents. *Stebler vs. Riverside Heights Orange Growers' Ass'n (C. C. A. 9)* 205 F. 735, 740.”

See also *Sanitary Refrigerator Co. vs. Winters*, 280 U. S. 30, on page 42, wherein the Court said:

“A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement.”

Defendants' Extension or Auxiliary Frame Does Not Relieve Them of Infringement.

In the *Shoemaker* patent the garment supporting member or frame carries at its inner end one or more removable garment bars or hangers. This frame is movable from a vertical position within the cover to a horizontal position overlying the body section of the luggage case. Both sets of defendants manufacture and sell a luggage case wherein the main frame is equipped with an auxiliary or extension frame. When the frame and luggage case of these defendants are being used the auxiliary frame is folded over into a coinciding position with the main frame and the removable garment bars are then located on the hinged side of said supporting member or main frame.

Mr. A. A. Ritter, during the taking of his deposition, examined the luggage cases of both sets of defendants and in fact loaded or packed the same with the auxiliary frame members in their folded over or collapsed positions. This was likewise done by our expert Mr. Roemer during the trial of the cause in the District Court and it appeared that the defendants' devices merely provided for alternative modes of packing or loading. That is to say, in some instances it might be desirable to load the fixtures with the auxiliary frames projected to vertical positions. Either mode of loading is equally practical. With reference to the auxiliary frames on defendants' fixtures Mr. Ritter stated (R. p. 180):

“This is merely additional and the case can be packed with the fixture in a vertical position or in a horizontal position.”

On R. p. 181 Mr. Ritter also brought out that when the fixture of the defendants is functioning as a carrying unit within a packed case the entire fixture is lodged within the cover of the case and the individual removable hanger bars are always positioned at the inner end of the cover adjacent the hinged connection of the cover with the body.

The matter of the auxiliary or extension frames on the defendants' fixtures was also discussed at the trial by Mr. Roemer who said (R. pp. 220 and 221):

“This is a feature entirely additional to the other features, and, according to my first demonstration, the fixture may be used in either way * * * and it must at one time be in the position I am illustrating now; that is, by the main supporting frame in a horizontal position so that when the frame is raised to its packed position within the cover it folds and stores the garment.” * * * “In this case also the garment is placed on the bar in this vertical position if desired whereafter it must be returned to its horizontal position, and whereafter the main supporting frame, the *important part of the structure*,

must be used in the way that is taught by the Shoemaker patent to raise and store and pack the garments all in one operation.”

On R. p. 222 the witness brought out that in plaintiff’s Exhibit 7, the Koch et al accused structure, lugs on the side arms of the extension frame engage over the side arms of the main frame so that when the extension frame is in its folded position the arms of the auxiliary frame and the arms of the main frame become one and move as a unit. With respect to plaintiff’s Exhibit 8, the Silverman et al structure, the witness on R. p. 222 of the transcript brought out that a transverse bar on the main frame supports the auxiliary frame when it is folded over and,

“the auxiliary arms and the main arms come together and function as a single arm. There is no added function in this use of the device gained by the use of the auxiliary arms.”

In attempting to argue that their structures do not infringe the Shoemaker patent by virtue of the extension or auxiliary frames, the defendants lose sight of the fact that in normal usage—that is when a case is packed and carrying garments—the frames with the garments thereon are in fact collapsed and lodged within the covers of the luggage cases. During these periods the auxiliary frames have absolutely no function and the only effective instrumentality is the composite frame which has mounted on its inner end the removable garment bars. The defendants cannot escape the charge of infringement by saying that some times, during optional disposition of the fixture for packing purposes the parts are temporarily disposed in a manner different than the disposition of the relative parts in the Shoemaker patent. The fact is that this is only a temporary arrangement of the parts of the mechanism. Most of the time and during actual usage of a luggage case the parts of defendants’ fixtures are located, used, and operate precisely as the fixture of the Shoemaker patent.

A similar situation was before the Court in the case of *Farrington vs. Haywood*, 35 Fed. (2d) 628. In this case the defendant, as here, alleged that infringement did not exist because during some stages of the operation of its device the elements were disposed and functioned differently than in the device of the patent. However, the Court said:

“It will therefore infringe at some stage of its operation. *It is unnecessary that it infringe at all stages.* The elements of helicoidal twists and ‘journaling means’ do not appear in the claim, and their omission in substance, from the defendant’s device does not therefore avoid infringement of this claim. Doubtless the defendant’s stirrer has some functions not possessed by the plaintiff’s, and it may be under some conditions an improvement thereon, but this fact also does not avoid infringement.”

Another way of looking at this situation is that possibly the structure of the present defendants is the structure of the patent *plus* an additional element. The law is well settled that infringement cannot be avoided by adding something to a patented combination. If the patented combination is found in the accused structure there is infringement regardless of how much or how little the defendants have seen fit to add to the patented combination. Citations on this point are numerous and we mention the following:

“Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form, or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain its results by the use of the same or equivalent mechanical means.” *Lourie vs. Lenhart*, 130 F. 122, 64 C. C. A. 456; (*Leston*) *Letson vs. Alaska Packer’s Association*, 130 F. 129, 64 C. C. A. 463; *Eck vs. Kutz*, (C. C. A.) 132 F. 758.

The Ninth Circuit Court of Appeals has also heretofore passed on the question at hand and we direct attention to *Smith Cannery Machines Co. vs. Seattle-Astoria Iron Works*, 261 Fed. 85, wherein the Court on page 88 said:

“The fact, if it be a fact, that the infringing machine is superior, more useful, and more acceptable to the public than that of the appellant, does not avoid infringement, so long as the essential features of the appellant’s patented machine are used, unless its superiority is due to a difference in function or mode of operation or some essential change in character.”

It is also interesting to observe that the defendants, in the Court below attempted to invoke the unique theory that liability for infringement may be avoided by virtue of operation under a patent issued after the issuance of the Shoemaker patent in suit. In this respect the defendants Silverman et al alleged that the fixtures they are *now* using are manufactured by Presto Lock Company under a certain Levine patent No. 2,091,931. The fact of the matter is that this Levine patent issued August 31, 1937, or approximately five years after the issuance of the Shoemaker patent in suit. Also, this patent purports to cover and covers simply a refinement in the matter of latch and projecting means for the trolley rods at the outer end of the auxiliary frame. In regard to this late Levine patent the Court’s attention is respectfully directed to the testimony of Mr. Roemer commencing on R. p. 400 as follows:

“Every claim of the Levine patent is limited to the structure which supports the garment bars on a fixture in a suitcase. That structure is a little tube with a plunger in it and snaps at the end of the plunger and a hook on the ends of the garment bars. The Levine patent is directed solely to that portion of a fixture.”

The defendants Silverman et al argued that inasmuch as their present fixtures are marked with the patent num-

ber of the Levine patent, a presumption attaches that infringement does not exist. This is an untenable proposition. It very frequently happens that the Patent Office will grant improvement patents after the issuance of earlier dominating patents but the structures of the improvement patents cannot be manufactured and sold without a license from the owners of the earlier dominating patents.

This particular question was clearly decided by the Supreme Court of the United States in *Temco Electric Motor Co. vs. Apco Mfg. Co.*, 368 O. G. 259, which case is authority for the proposition that an improver cannot appropriate the basic patent of another, and an improver without a license is an infringer, and may be sued as such.

Likewise the Ninth Circuit Court of Appeals has spoken on the same subject in *Jonas et al vs. Roberti*, 7 Fed. (2d) 563 wherein the Court stated, Page 564:

“The appellants rely upon the presumption which attaches to the issuance of their patent, and thereon argue that there must be a substantial difference between the two combinations. But the conclusion does not follow. The Malerstein patent may have been issued upon the ground that it discloses an improvement over the appellees’ mattress sufficient to entitle Malerstein to protection in that which he added to the art. But an inventor cannot be deprived of the benefit of the idea which he has disclosed to the public by improvements subsequently made by another in carrying forward the art.”

The argument of the defendants Silverman et al in this particular is furthermore of no avail because the fixtures, bearing the patent number of the Levine patent were only adopted by them at a recent date. The record of this case will disclose that prior to the institution of this litigation the defendants Silverman et al utilized fixtures manufactured by Milwaukee Stamping Company which were not un-

der the Levine patent, as exemplified by plaintiff's Exhibit 8. Furthermore the fixtures utilized in the wardrobe cases of the defendants H. Koch & Sons, as exemplified by plaintiff's Exhibit 7, are not manufactured under any patent.

Law on the Subject of Invention and Novelty Over the Prior Art.

The defendants, as is customary, assert that the Shoemaker patent does not, in the light of the prior art possess novelty and disclose invention. Attention is directed to the fact that the claims of the Shoemaker patent are combination claims. In a combination even though all of the elements separately are old in the art, which is not the case here, invention may be predicated on so associating and arranging the various elements as to produce a new and novel combination susceptible of producing results and advantages not suggested by the prior art.

In this connection it may be well to briefly refer to a Ninth Circuit case dealing with this question of invention and novelty.

Bankers Utilities Co. Inc. vs. Pacific National Bank, 18 Fed. (2d) 16, C. C. A. 9th Circuit, March 28, 1927.

"It is recognized that merely to assemble old elements does not constitute invention. But, upon the other hand, an aggregation and association of old elements may constitute invention, if it rises above mere mechanical skill and produces utility of a superior virtue to that previously attained." *Bloss vs. Spangler*, 217 Fed. 394 (9th C. C. A.).

In the case at bar the defendants contend that certain of the prior art patents might by modification or changes, be rebuilt into a pertinent structure. On this point the Court in the above case made a rather significant and parallel statement as follows:

“Defendants show that a Gillette razor case, upon which they read the claims of the Farrington patent, No. 1,217,291, can, by certain changes or additions, be made to exhibit the essential features of plaintiffs’ cover; but Gillette cases were admittedly in common use, and it remained for counsel, under the exigencies of this litigation, and with plaintiffs’ commercially successful device as a model, to suggest the additions. Anticipation is not made out ‘by the fact that a prior existing device, shown in a prior patent, may be easily changed so as to produce the same result as that of the device of the patent in suit where the prior device was in common use, without it occurring to any one to adopt the change suggested by the patent in the suit.’” *Blake Automotive Equipment Co. vs. Cross Mfg. Co.*, (C. C. A.) 13 F. (2d) 32.

See also:

Butler vs. Burch Plow Co., 23 Fed. (2d) 15; C. C. A. 9th Circuit.

The Presumptions Attaching to the Shoemaker Patent in Suit.

The Shoemaker patent in suit is entitled to a number of presumptions which arise from the situations briefly listed as follows:

1. The presumption of validity and novelty attaching to a patent granted by the United States Patent Office after a thorough examination of the art by trained officials.
2. The invention met with immediate commercial success and acceptance extending from 1929 to date and the defendants, appropriating the invention some ten years after its introduction and commercial exploitation in this country cannot well contend that it was not a meritorious advance over the prior art.
3. A tremendous number of hand luggage cases embodying the Shoemaker invention have been

sold in the United States from coast to coast through leading stores and dealers and the purchasing public has demanded this type of luggage case because of its decided superiority. The Shoemaker patent is not a *paper patent*.

4. Leading United States manufacturers voluntarily negotiated for and secured licenses under the Shoemaker patent, believing it to be a marked advance and relying on the government grant.
5. The Vogue Luggage Co. of San Francisco, California conceded infringement of the Shoemaker patent and validity thereof, accepted a license under the patent and gave this plaintiff a consent decree in a pending suit in this jurisdiction.

All of the above spells recognition of the patent, decided commercial success and acceptance, and advantages in the patented structure recognized by experienced people in the industry to which it pertains.

Of the before listed presumptions, items Nos. 2, 3, 4, and 5 were found to be adequately supported by the evidence by the District Judge because he found in Finding of Fact No. 4:

“That the invention of the patent in suit has had a great commercial success and has gone into wide and extensive use in the United States and elsewhere.”

The District Judge furthermore found (Finding No. 5 and Conclusion No. 2) that the accused structures of the defendants were fairly readable upon and responded to the claims of the Shoemaker patent in suit.

On the question of the presumption of validity attaching to a patent especially where there was marked commercial success, see the Ninth Circuit case of *Claude Neon Electrical Products vs. Brilliant Tube Sign Co.*, 48 Fed. (2d) 176.

Also, on the presumption of validity see:

Smith vs. Goodyear, 93 U. S. 486, 498;

Marsh vs. Seymour, 97 U. S. 348;

Minneapolis etc. Ry. Co. vs. Barnett & Record Co., 257 F. 302 (C. C. A. 9);

Reinharts, Inc., vs. Caterpillar Tractor Co., 85 F. (2d) 628 (C. C. A. 9).

THE DEFENSES.

As stated earlier in this brief the defenses in this litigation involve but two general questions—first, the question of infringement of the claims of the patent in suit; and second, the question of the validity of the claims of the patent in suit. As no cross appeals were filed it must be assumed that the appellees are not attacking any of the findings and conclusions of the District Court. An analysis of the District Court's findings and conclusions of law will verify the fact that the judgment in these cases was based *only* on the opinion of the District Judge that the claims of the Shoemaker patent in suit were invalid because of an alleged 1928 unpatented development by one Maurice P. Koch, a son of one of the defendants in this litigation. The District Judge rejected all of the other miscellaneous defenses, found infringement if the Shoemaker patent is valid and therefore the main issue in this appeal must be concerned with whether or not the District Judge was correct in accepting the submitted proofs relative to the early Maurice P. Koch developments. As a further development of this thought, even though the District Court found such proofs to be acceptable it is our contention that the same were not properly applied with respect to the law and that under the controlling law the decision of the District Court must be reversed because the

evidence does not support Findings Nos. 6 and 7 and Conclusion of Law No. 1.

Under Rule 52 (a) of the Federal Rules of Civil Procedure findings of fact may be set aside by an appellate Court if clearly erroneous. It is our contention that in the instant situation the evidence does not support the finding and the corresponding conclusion of law to the effect that the Shoemaker patent in suit is anticipated by the alleged early Maurice P. Koch development. In the District Court there was simply a misapplication of the proven facts to the law.

The Alleged Maurice P. Koch Prior Invention, Prior Knowledge and Use and Sale.

In regard to this defense (the only defense accepted by the District Judge) we respectfully urge the following contentions:

1. The alleged prior invention and prior public use and sale defense re the Maurice P. Koch activities was not established by the character of proof required to overthrow a patent and must be rejected.
2. It is open to serious conjecture as to what form of structure Maurice P. Koch did in fact produce in 1928.
3. The defendants' Exhibits K, L and S exemplify fixture equipped luggage cases constructed just prior to the hearing of these causes in the District Court and said models were admittedly constructed in view of the exigencies of the litigation. Even as constructed at this late date the cases do not include fixtures having all of the claimed elements and resulting advantages of the structure of the Shoemaker patent in suit.

Before giving the defense material relating to the structure allegedly invented and produced by Maurice Koch in early 1928 any serious consideration, the Court should

carefully weigh and measure the testimony and evidence as against the rules enunciated by the Courts to the effect that an alleged prior knowledge and use or public use and sale is not acceptable to invalidate a patent if it is predicated primarily on parole evidence, especially if such evidence is produced at a date long after the events are supposed to have transpired. To be entirely charitable it must be said that this defense material is certainly open to serious question and raises substantial inquiries as to the authenticity of the same. The alleged prior invention and public use and sale by Maurice Koch was set forth in only the most general of terms in the Koch et al Answer filed many months before the hearing of this cause. In January, 1940, the plaintiff, through interrogatories sought to elicit from the defendants further information and tangible evidence of this Maurice Koch device. At that time the defendants could not furnish the plaintiffs with any evidence in support of the alleged prior use device. Four days before the trial of the cause, or on or about March 9, 1940, the defendants finally furnished plaintiff's counsel with answers to the interrogatories, supported by a photograph of a luggage case with the fixture therein (R. p. 79). The reason that this material was not furnished to the plaintiffs at an earlier date was because *it was not in existence*. The luggage case was admittedly manufactured for the purposes of this trial at a date just prior to the hearing (testimony of Maurice Koch, R. p. 292). The defendants would have this Court invalidate a duly issued United States patent of great merit on the basis of a structure produced solely for the exigencies of the litigation.

The exhibits in support of this prior public use and sale defense included defendants' Exhibit K, a newly built box having therein new fixtures; defendants' Exhibit L, a newly built box having therein allegedly old or original fixtures; and defendants' Exhibit S, which was admittedly con-

structed during the trial of the cause because the fixtures of Exhibits K and L did not function in a manner to permit their usage. In addition to these luggage box exhibits the evidence includes defendants' Exhibits M, N, O, and P (R. Vol. II, pp. 683, 684 and 685), which are respectively a Larkin Specialty Company production list, and ledger sheets and bills relating to H. Koch & Sons' transactions with this company for fixtures. Defendants' Exhibit R consisted of metal cups or brackets allegedly used in the early Koch structure. It is difficult to understand how the defendants could produce additional fixtures at will when it was understood from the testimony of Mr. Maurice Koch (R. pp. 292, 296, and 297) that the fixtures in defendants' Exhibit K were the only fixtures remaining from the original Larkin order of 1928.

In an attempt to support this alleged prior use and public use and sale, Mr. Maurice Koch first took the witness stand. Let us first understand that he is a son of Herman Koch and is connected with the defendant company known as H. Koch & Sons. Therefore, Mr. Maurice Koch was a most interested witness and he testified to events and transactions which transpired twelve years ago. We submit that the human memory is not as infallible as Mr. Koch would have us believe. Mr. Maurice Koch, of course, described the structures of Exhibits K and L but had to admit that the Exhibits were built at a very recent date. With relation to the prior art in 1928, the witness admitted (R. p. 291), that it was common to use a single roller type of fixture put in the lid of a wardrobe box. As we will point out hereinafter, that, according to our theory, is where the removable bar and sockets of the Koch fixtures were installed in the early 1928 cases. If this was not the situation why did not Mr. Koch produce and offer in evidence an original luggage box which was in his factory and

from which he removed the fixtures he subsequently assembled in defendants' Exhibit L? Mr. Koch, on pp. 296 and 297 of the Record, stated:

“The shorter one, here I took from an old box that had been, well, it was all smashed and I had it lying around the factory, and I just picked this up.”

It would seem that the original box, allegedly available, constituted the best evidence as to what Mr. Maurice Koch had produced in 1928. We feel it must follow that the substitute box, offered in evidence, did not have the fixtures mounted therein in the same relationship as they were in the early discarded box. According to the Shoemaker patent in suit, the particular arrangement and relationship of the various elements to produce compound folding of garments within the cover of the luggage case, is of the essence.

On page 296 of the Record the witness stated that in 1928 five thousand wardrobe cases with the fixtures therein were sold. The witness, Albert Kantrow, testified (R. p. 228) that from 1928 to 1931 or 1932 he sold at least one hundred to one hundred and fifty per month of the Maurice Koch luggage cases with the fixtures therein. These luggage cases were sold in San Francisco, throughout the West Coast, and all over in that vicinity. A piece of hand luggage is not fragile nor does it become deteriorated or worn out in a short time. It is used infrequently and many pieces of luggage last owners a lifetime. Is it not exceedingly strange, therefore, that these defendants who did business in the San Francisco area and on the West Coast could not or did not produce a single one of the luggage cases on which they rely? Instead they merely offered in evidence recently constructed and assembled luggage cases arranged to suit their particular present urgent needs. In the absence of the production of an original luggage case, or a satisfactory explanation as to why one was

not produced, the Court should totally disregard this entire defense and the physical Exhibits K, L and S. From the commencement of this litigation in early July, 1939, to March, 1940, the defendants had ample time in which to find and produce an original case. This was not done. Moreover, the defendants had the opportunity of and refused to produce an alleged original box in their own factory, but instead removed the fixtures from this box and installed them for their own purposes in a newly constructed luggage case box.

We are willing to admit that the Larkin Specialty Company manufactured fixtures for H. Koch & Sons in 1928. It is possible that the fixtures which this company did manufacture were similar to the fixtures installed in Exhibits K, L, and S, but we strenuously deny the fact that these fixtures were originally mounted in the luggage case box in the manner now disclosed in these exhibits. Mr. Maurice Koch and other witnesses for the defendants frankly admitted that luggage cases of the Winship type, employing only a swingable U-frame, were in quite general usage in 1928 and thereabouts. In some instances the arms of these frames were made longer than in the specific Winship showing. It was also a very common practice in those days to mount rods or garment bars in sockets *in the upper end of the cover* of a luggage case. (See patent to Fasel and Garland, No. 1,382,964 (R. Vol. II, p. 558), and testimony of Kantrow R. p. 335.) Our conception of the true arrangement of the early Maurice Koch fixtures in a luggage case is embodied in the illustration opposite page 44. It is our sincere belief that the swing frame was mounted in the cover with the axis rather remote from the hinged connection of the cover, as in the Winship type of luggage case, and it is our further belief that the sockets and removable bar or rod were mounted at the upper end of the cover, just as in the Fasel and Garland



indicating the inadequacy of the device in the form exemplified by the two exhibits. The alleged early inventor, Mr. Koch, was at a loss as to how to satisfactorily explain this situation. The plaintiff knows and its expert, Mr. Roemer, clearly established that this condition was due to the elongation resulting from the mounting of the removable bar independently of the swing frame. In other words, when the frame is swung into the cover there is a decided lengthening in the dimension between the inner bar and the outer bar of the frame, which imposes a severe pull on the inner bar as well as a distortion of the garment or a stretching or rubbing action thereof. From a commercial standpoint this condition is highly objectionable even if steps are taken to prevent the undesired removal of the inner bar. The defendants must recognize this fact because in their present commercial structures they do not follow the teaching of the Koch models in this particular but do in fact mount their removable bars directly *on the inner end of the swing* frame, precisely as is taught by Mr. Shoemaker.

To return to the difficulties of Exhibits K and L, after an evening of thought Mr. Maurice Koch appeared in Court the following day with a newly constructed luggage case having the sockets for the inner bar mounted in a manner reverse from that of the mounting of these sockets in Exhibits K and L (R. p. 329). This reconstruction of the device prevented the removable bar from jumping out of its sockets, but it did not overcome the strain and pull on the garment and the lengthening of the dimension when the fixture was manipulated toward its packed position, as was clearly established during the trial by actual tests and measurements. On page 333 of the Record it appears that the distance between bars changed from eleven inches to approximately thirteen inches, or an elongation of two

inches, which would impose a severe strain on a fragile silk garment.

This particular incident of the alleged inventor in originally assembling fixtures (Exhibits K and L) in an erroneous manner, clearly demonstrates the futility of attempting to predicate proofs of an alleged prior use on oral testimony concerned with the events which transpired many years ago. The alleged inventor himself actually installed the fixtures in Exhibits K and L, or supervised this work. In one of these cases the fixtures were removed from the broken box and immediately put into the newly constructed box. Therefore the inventor, Mr. Koch, and a workman, had this original installation before them to guide them. Nevertheless they admittedly erred. It is logical to believe that additional errors in memory and judgment throughout the twelve-year period from the origin of this prior use fixture to its assembly for use in Court could have taken place.

The proofs in regard to the alleged Koch prior use and public use and sale were all offered through interested parties. For the most part, the proofs are entirely of a parole nature. Of the documentary exhibits it has been demonstrated that the luggage cases (Exhibits K, L, and S) are not necessarily authentic and were admittedly produced recently for the purposes of the trial. We do not question the authenticity of the Larkin Specialty Company records, but these records only establish that this company made certain forms of fixtures for the Kochs in 1928. The Shoemaker patent can only be defeated by prior art showing the same relationship of fixture devices for accomplishing compound folding of garments within the cover of a luggage case. We have demonstrated that the fixtures which Larkin Specialty Company made for the Kochs might very readily, and very plausibly were, mounted in luggage cases in a relationship different from that of the Shoe-

maker patent in suit. Therefore the documentary evidence on this subject has little or no value as at best it only establishes the manufacture of certain forms of fixtures for the Kochs.

In an attempt to bolster this very unsatisfactory evidence the defendants availed themselves of the testimony of several decidedly interested parties. Besides the witness Mr. Maurice P. Koch they had the testimony of Albert Kantrow and William J. Locke. Both of the latter gentlemen are in the business of selling hand luggage and have handled or are handling luggage for H. Koch & Sons. In so doing, it is very possible that they are infringers of the Shoemaker patent in suit and are certainly interested in seeing the Shoemaker patent invalidated.

Excerpts From the Testimony With Relation to the Alleged Early Koch Device, and Others Matters.

Heretofore we have demonstrated the fact that the independent rod or bar disclosed in the exhibits in relation to the early Koch device might very readily have been mounted in the upper end of a luggage case cover free of any association with a swing frame. This was a popular form of commercial arrangement in the early days. Mr. Maurice Koch admitted this fact. He was questioned as to some of the early fixtures which H. Koch & Sons used in luggage and stated that they began to use fixtures in the latter part of 1927. The following testimony is of interest:

“Q. What type of fixture was that if you remember?

“A. Well, that was just a *single roller type put in the lid* of a wardrobe box, single roller hanger with a short elbow, and it was attached to the side walls of the cover, I should judge four or five inches from the free end of the case” (R. p. 291).

This same witness further admitted that a simple frame of the type found in Exhibits K and L was in fact used in wardrobe luggage, without the additional removable bar. The testimony in this regard (R. p. 301) reads:

“Q. Is it not possible that in the earlier days of wardrobe luggage a simple frame of the type you have installed here could have been used in the cover of a case without the additional removable bar?

“A. That’s right.

“Q. Might it not have been mounted higher in the cover of a longer case?

“A. That’s right.”

On page 308 of the Record is a direct admission by Mr. Maurice Koch that his company did in fact sell luggage with fixtures mounted in the manner we contend was the arrangement with respect to the fixtures of Exhibits K and L. The witness stated:

“Well, just prior to this fixture (meaning the fixture of Exhibit K or L) we sold a single rack fixture in the lid of the cover; that is *in the top end*, the upper free end. We sold those shortly after that, too.”

Mr. Kapps, of Larkin Specialty Company, admitted on page 317 of the Record, that the fixtures before the Court did in fact differ from the specifications in the production list, defendants’ Exhibit M. To demonstrate the obvious fact that the witnesses in this defense could not have infallible memories as to what transpired in the early days, we refer again to the testimony of Mr. Kapps, on page 318 of the Record, in which, after he was interrogated as to his recollection in regard to a fixture, he stated:

“I can’t remember what I did fifteen years ago.”

We think that this is a very excellent statement.

Albert Kantrow, a supporting witness called by the defendants, admitted, on page 335 of the Record, that,

“About 1925 and 1926 I was buying cases that had two little rods on the top * * * .”

This again emphasizes our theory that the removable bars in the Koch exhibits might very logically have been arranged independently in the upper end of a luggage case cover. This witness (R. p. 228) definitely referred to the vast number of early Koch luggage cases he presumably sold, with many of the same being sold in the San Francisco territory. He frankly admitted that luggage cases similar to defendants' Exhibits K, L, and S would not sell today. This would seem to be a recognition that the luggage cases as exemplified by the above mentioned exhibits were decidedly different in structure, operation, and advantages from the Shoemaker type of fixtures and that the Shoemaker patent constituted invention thereover.

The Alleged Early Koch Device of Exhibits K, L, and S, Even If Accepted, Does Not Anticipate Shoemaker's Relied Upon Claims.

The relied upon claims of the Shoemaker patent require, among other things, the removable mounting of one or more independent garment hangers or bars, directly on the inner end of the swing frame. This produces a very simple structure and requires a minimum of mounting elements for the fixture relative to the luggage case. More important, however, when the individual hanger bars are carried directly by the frame there is no variation in the distances between the two folding bars when the frame is swung from a horizontal position to a packed vertical position within the cover of the case. This was demonstrated by tests made during the trial. On the other hand, with the devices of Exhibits K, L, and S an admitted elongation of approximately two inches took place. The disadvantages of this elongation have heretofore been dealt with, and of

course the strain which this elongation imposes upon the fixture and the supported garment is so severe as to cause the inner garment bars to jump out of their mountings and hang substantially thereabove unless means are provided to prevent this contingency.

We may further state that there must have been vast differences between the early structures and that covered by the Shoemaker patent in suit or the defendants, and those who sold their products, would not have abandoned those early forms of cases and substituted in lieu thereof the very desirable fixture equipped cases constituting the accused structures of this litigation. In those accused structures the individual garment bars are *carried directly* by the inner ends of the frame arms so as to prevent any objectionable elongation during movements of the fixture.

The relationship of the early Koch devices to the patent in suit and to the accused structures was best expressed by the alleged early inventor, Mr. Maurice P. Koch. On page 334 of the Record, after being questioned with reference to the fixture of Exhibit S in relation to the structures which are the subject of this litigation, the witness distinctly stated:

“It (meaning one of defendants’ accused structures exemplified by plaintiff’s Exhibit 7) is an *entirely different fixture*. It operates differently from this (meaning the fixture of Exhibit S).”

Law on the Quality of Proof and Evidence Required to Establish Prior Use, Prior Inventorship, etc.

With relation to the early Maurice Koch developments whether the same be termed prior public use and sale or prior knowledge and use, or prior inventorship, the tests as to the proofs required are the same. The burden of

proof is on the defendants and the Maurice Koch early developments, with the mounting of the fixtures in a piece of hand luggage in a precise relationship must be proven beyond a reasonable doubt. This is an axiom of Patent Law to which the defendants have paid scant attention. The Shoemaker patent in suit cannot be destroyed on mere conjecture and speculation, or on unsupported testimony of interested parties as to what transpired twelve years ago. The defendants are under the rule that every reasonable doubt should be resolved against them. One of the finest expressions of the law on this subject is found in the famous *Barbed Wire Patent Case* reported in 143 U. S. 275. There, the Supreme Court, on page 284, stated:

“We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be dependent upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defence of a prior use of the thing

patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer. The doctrine was laid down by this court in *Coffin vs. Ogden*, 18 Wall. 120, 124, that 'the burden of proof rests upon him,' the defendant, 'and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view.' This case was subsequently cited with approval in *Cantrell vs. Wallick*, 117 U. S. 689, 696, and its principle has been repeatedly acted upon in the different circuits. *Hitchcock vs. Tremaine*, 9 Blatchford, 550; *Parham vs. American Button-Hole Machine Co.*, 4 Fisher, 468; *American Bell Telephone Co. vs. Peoples' Telephone Co.*, 22 Fed. Rep. 309.'

Not only does this quotation clearly define the requirements in the matter of proofs on alleged unpatented devices but it very clearly and succinctly explains the reasons and logic underlying this established principle. It suggests the possibility of forgetfulness on the part of witnesses, their liability to mistakes, and aside from the temptation to actual perjury, there is the proneness on the part of the witnesses to relate facts which they feel the person calling them will benefit by. These elements are all present in the testimony by which the defendants in the instant litigation seek to establish the Koch developments.

May we also direct attention to the following additional citations:

Paraffine Companies, Inc. vs. McEverlast, Inc., et al, 84 F. (2d) 335, 339, and
Carson vs. American Smelting & Refining Co.,
 4 F. (2d) 463, 468.

In no circuit has this rule been more rigidly enforced than in the 9th. Thus, in the case of *Parker vs. Stebler*, 177 Fed. 210 at 212, this court said:

“It is well settled that the defense of prior use must be established by evidence which proves it beyond a reasonable doubt. The question of novelty is a question of fact. *Turrill vs. Michigan S. R. R. Co.*, 1 Wall. 491, 17 L. Ed. 668. And it has been held that the oral testimony of many witnesses, if unsupported by any evidence consisting of documents or things, must be very reasonable or very strong to establish the defense of prior use. * * * In brief, the courts have recognized the rule that the oral testimony of witnesses speaking from memory only in respect to past transactions and old structures claimed to anticipate a patented device, physical evidence of which is not produced, is very unreliable, and that it must be so clear and satisfactory as to convince the court beyond a reasonable doubt before it will be accepted as establishing anticipation (citing cases).”

See also:

Diamond Patent Co. vs. Carr, 217 Fed. 400.

The attempts to shatter the validity of plaintiff's patent most obviously have not attained

“the same degree of proof as would be necessary if the life or liberty of the patentee himself depended upon the novelty of the invention.”

to use the language of a court in paraphrasing the Supreme Court rule relating to the burden of proof which must be borne by a defendant.

Miscellaneous Prior Art Patents Relied on by the Defendants.

On pages 9 to 14 inclusive *supra* of this brief we have discussed the alleged prior art patents offered in evidence by the defendants. These patents have no anticipating

value. It may further be stated that of the prior art patents offered in evidence by the defendants the following were file wrapper patents:

Boyd et al	No. 1,185,971	(R. Vol. II, p. 533);
Burchess	“ 1,081,014	(R. Vol. II, p. 549);
Fasel and Garland	“ 1,382,964	(R. Vol. II, p. 558);
Stenwer	“ 1,641,704	(R. Vol. II, p. 564); and
Winship	“ 1,728,223	(R. Vol. II, p. 568).

It is a definite fact that all of these file wrapper patents were thoroughly considered by the Examiner during the prosecution of the application for the Shoemaker patent and he found that the claims in the Shoemaker patent defined novel and patentable subject matter over the disclosures in these references. There is nothing in the showing in any of these patents to indicate that the Patent Office Examiner was not correct.

It is also improper for the defendants to assume or allege that the Patent Office Examiner overlooked the other prior art patents in evidence. The Patent Office Examiner had available and undoubtedly searched voluminous files in which are collected patents in this art from all countries of the world. A patent Examiner never burdens an applicant with citations of all of the references included in his files. He merely selects and makes of record the ones he believes to be of most significance in relation to the submitted claims. We believe that the Examiner was convinced that his citations (the file wrapper prior art) were representative and were as pertinent to the Shoemaker claims as any additional prior art he might have selected. It is only necessary to glance through the many miscellaneous prior patents in this record, which were cited by the defendants, to become thoroughly satisfied that these prior patents relate to structures far removed from the novel features of the Shoemaker luggage case.

The Storch Patents.

Throughout the trial in the District Court the defendants urged most strenuously the several Storch patents (R. Vol. II, pp. 539 and 661), contending that in view of the same the Shoemaker patent must be invalidated. It is difficult to follow the reasoning of the defendants in this respect because the several Storch patents *are not in the prior art*, as will hereafter appear, and secondly the structures covered by the Storch patents are so foreign to the combinations covered by the relied upon claims of the Shoemaker patent as to render the Storch patents valueless for any alleged purposes of anticipation.

The application for the Shoemaker patent in suit was filed in the United States on December 24, 1928. This application was predicated on the origin of the invention by Mr. Shoemaker some little time prior to the actual filing date. In presenting his application Mr. Shoemaker made the usual sworn oath containing among other things the statement that,

“He does not know and does not believe that the same (the invention in question) was ever known or used before his invention or discovery thereof.”

This means that insofar as Mr. Shoemaker was concerned, the idea was original with him and there was compliance with Section 4886 of the Revised Statutes (U. S. C., Title 35, Sec. 31).

In relation to the Storch patents the defendants cannot, of course, contend in any way that the subject matter of the same was known or used by others in this country before the Shoemaker discovery. The Storch U. S. patent was applied for May 9, 1929, or substantially five months *after* Mr. Shoemaker filed his application in the United States, and the Storch Austrian patent did not issue and as a result was not a publication until March 25, 1930, or about

a year and a half *after* Mr. Shoemaker filed in the United States, so it is absolutely clear that there was no patenting or describing of the invention in any printed publication in the United States or any foreign country before the Shoemaker discovery, or more than two years prior to Shoemaker's application. There is no evidence that the Storch device was in public use or on sale in *this country* for more than two years prior to Shoemaker's application.

It will thus be seen that under the controlling Statute Mr. Shoemaker was absolutely correct in filing his application and was entitled to make the supporting oath. Nothing in relation to the Storch patents counteracts the requirements of Section 4886 of the Revised Statutes.

Not being able to derive any benefit from the Storch patents in this normal manner, the defendants presented a very unique and untenable theory. In effect they claim that the Storch Austrian patent is for the same invention as his United States patent and, hence, under the International Convention Storch's United States application is entitled to a constructive filing date the same as the date on which his Austrian application was filed, namely September 1, 1928. For this line of reasoning the defendants resort to Section 4887 of the Revised Statutes (U. S. C., Title 35, Sec. 32). The pertinent portion of this section of the Statutes reads as follows:

“An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privilege to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed with-

in twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed.”

The Court will appreciate, when this portion of Section 4887 is considered in connection with its historical background and in connection with Section 4923 of the Revised Statutes, with the further detailed consideration of the various judicial interpretations of these sections of the Statutes, that Section 4887 is solely for the purpose of granting reciprocal rights to inventors of countries belonging to the International Convention. *These rights are purely personal.* A foreigner, who has filed a patent application in the United States, providing he has fulfilled the requirements of Section 4887, may in a priority contest, get the benefit of his earlier filing date in a country foreign to the United States, *but this right only extends to the foreign applicant in the United States or someone in privity with him.*

How the defendants' position can be asserted in the face of Revised Statute 4923 (U. S. C., Title 35, Sec. 72), is beyond comprehension as Section 4923 is directly controlling in the instant situation. This section of the Statutes reads as follows:

“Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.”

Let us apply this section of the Statutes (Section 4923) to the Shoemaker invention and United States application

as affected by the Storch patents. Mr. Shoemaker, the patentee, "at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented." This fact is not contradicted and is supported by the oath which was made at the time that the Shoemaker application was filed. The Statute goes on to say that the invention or discovery (Shoemaker's hand luggage) shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his (Shoemaker's) invention or discovery thereof, *if it had not been patented or described in a printed publication.* Assuming that the Storch development was known or used in Austria before the filing of the Shoemaker application in the United States, this fact is of no consequence because it is established law that prior knowledge or use in a foreign country will not invalidate a United States patent. As stated by the section of the Statutes, the only things which could have affected the validity of the Shoemaker patent would have been prior patenting or description in a printed publication. It is elementary that prior patenting requires the actual grant of a patent—not the filing of an application. A patent application is a secret and confidential matter which is not in any way published to the world at large, and the public derives no benefit from a mere application. The Storch Austrian patent did not issue until March 25, 1930, which was *after* Shoemaker's filing date in the United States, so the Storch development was not patented in a foreign country before Shoemaker's application in the United States. The only publication date which can be relied on is the issue date of the Storch Austrian patent, namely, March 25, 1930, or substantially later than Shoemaker's filing date in the United States.

Sections 4923 and 4887 are parts of the same Patent Act which were both amended March 3, 1897 and subse-

quently. These two Sections were advisedly enacted and amended and there is no conflict as between the two, but Section 4887 is obviously limited, in its application, by the later Section 4923. As before pointed out, Section 4887 can only be for the purpose of affording reciprocal privileges under the International Convention, and the benefits of this Section extend only to the inventor or to those in privity with him. There is no logical reason why third parties, such as these defendants, can claim International Convention reciprocity rights in regard to the Storch developments and get the benefit of Storch's filing date in Austria, for the purpose of excusing their obvious trespass on the validly issued United States patent to Shoemaker. The Storch developments were not *patented* or described in a printed publication before Shoemaker's filing in the United States, and the most that can be said of the Storch developments is that an application was filed in Austria but not issued, a short time before Shoemaker filed in the United States. How could these defendants, or anyone else, derive any benefit from this secret filing of the application in Austria?

There is a strong and established body of law, enunciated by the Courts in this country, dealing with Section 4923 of the Revised States (on which we rely). Reference may here be made to the following:

Ex Parte Grosselin — Commissioner's Decision
1901—97 O. G. 2977.

This case directly holds that Section 4923, which provides that a patent shall not be declared invalid by reason of knowledge or use abroad, in effect authorizes the issue of a patent to the original inventor who first introduces a knowledge of the invention into this country and prohibits the issue of a patent to anyone else. This case furthermore states that the Patent Office in an interference,

“excludes testimony as to what was done by them abroad unless in the form of a patent or printed publication and issued the patent to the original inventor who is shown to have been the first to introduce the invention in this country, although the other party may have been the first to make the invention abroad.”

Westinghouse vs. General Electric — District Court Case 199 Fed. 907—Affirmed by the Court of Appeals for the Second Circuit 207 Fed. 75.

In this case Armstrong was the domestic inventor and De Kando had invented the subject matter in question in a foreign country and had even imparted knowledge of the invention to a person (Waterman) who had brought such knowledge into this country. The District Court interpreted the knowledge of the De Kando development which reached the United States as being a *constructive* reduction to practice but held that this would not defeat Armstrong's patent. The use of the De Kando invention and actual reduction to practice in Italy cannot be considered as the De Kando invention had not been patented or described in a printed publication. The Court said:

“The patent granted to a person here is not void, and is not to be denied to an original inventor here, for the reason merely the invention had been known or used in a foreign country before his invention or discovery thereof.”

The decision of the Court of Appeals accepts in full the District Court's findings and opinion. The Court of Appeals of the Second Circuit affirms the opinion of the Court of Appeals of the District of Columbia, which heard the interference proceeding, and holds,

“That for the purpose of defeating a patent application reduction to practice in a foreign country is a nullity unless the invention is patented or described in a printed publication.” * * * “Reduction

to practice in a foreign country can never operate to destroy a patent applied for here, however widely known such reduction to practice may be, either among foreigners or among persons living here, unless the invention be patented or described in a printed publication. To that extent Section 4923 qualifies the language of Section 4886, which without such qualification might well lead to a different result.”

The *Westinghouse vs. General Electric* case has been followed with approval in a long line of cases including *Minnesota vs. Barnett*, 257 Fed. 303 (312), and was further cited and approved in *Esnault-Pelterie vs. United States*, 27 U. S. P. Q. 272 (292).

The last word on the subject under discussion is found in a very recent Supreme Court decision. This is the case of *The Electric Storage Battery Company vs. Shimadzu*, reported in 41 U. S. P. Q. 155. The facts in this recent Supreme Court decision are not parallel to the facts in the case at bar, but we will mention the same briefly in order that this Court may understand why and how the particular questions concerning Revised Statutes 4886, 4887 and 4923 arose.

The respondent in the Supreme Court and the plaintiff below was a citizen of Japan and conceived and reduced to practice the subject matter of certain inventions in Japan not later than August, 1919. He did not disclose the inventions to anyone in the United States before he applied for his U. S. patents, which were applied for in the United States on January 30, 1922, July 14, 1923, and April 27, 1926, respectively. The inventions were not patented or described in a printed publication in this or any foreign country prior to the filing of the United States applications. The petitioner in the Supreme Court (defendant below), without knowing of Shimadzu's inventions, began the use of a machine, which involved the subject matter of

Shimadzu's patents, in Philadelphia in early 1921. As a defense for its actions of infringement the patentee (defendant below) contended that its knowledge and use of the invention in the United States was prior to Shimadzu's dates of application in the United States and therefore invalidated the latter's patents. The patent owners (respondent in the Supreme Court and plaintiff below) contended that it could avail itself of its development dates and actions in Japan, which were ahead of the defendant's dates in the United States, to establish priority as to his patent rights and to overcome the alleged invalidating effect of the defendant's prior knowledge and use in the United States (which was ahead of Shimadzu's filing dates in the United States.)

Here then we have a situation, unlike that in the instant case, where the patentee in the United States rightfully seeks to avail itself of the benefit of dates and actions in his home country to establish priority rights. The parties seeking to take advantage of the earlier dates in the foreign country *are the patent owners*. The Supreme Court held that this was proper, but the Supreme Court's opinion is of considerable interest in the case at bar because of the thorough discussion of Sections 4886, 4887 and 4923 of the Revised Statutes. The Supreme Court definitely spoke in regard to the interpretation to be given to Section 4923, which we are relying upon, and stated with reference to Section 4886:

“The test is whether the invention was known or used by others in this country before his invention or discovery thereof. * * * The elements which preclude patentability are a patent, or a description in a printed publication in this or any foreign country, which anti-dates the invention or discovery of the applicant.”

With reference to Section 4923 of the Revised Statutes, which we assert controls in the instant situation, the Supreme Court said:

“The effect of this section is that in an interference between two applicants for United States patent, or *in an infringement suit where an alleged infringer relies upon a United States patent*, the application and patent for the domestic invention shall have priority *despite earlier foreign knowledge and use not evidenced by a prior patent or a description in a printed publication.*”

By this very latest enunciation of the law by the highest Court in the land, it is obvious that Section 4923 controls as to the lack of effect of the Storch patents in this litigation. The defendants in the instant litigation cannot avail themselves of the Storch filing date in Austria because Storch's actions in Austria *are not evidenced by a prior patent or a description in a printed publication.* There is nothing that was done by Storch which resulted in any printed publication or patent prior to the date when Mr. Shoemaker made application for patent in the United States.

In the same opinion the Supreme Court furthermore stated:

“Thus, if a diligent domestic inventor applies, in good faith believing himself to be the first inventor, Section 4923 assures him a patent and gives it priority, *despite prior foreign use, even though that use is evidenced by a patent applied for after the invention made in this country.* The foreign applicant or patentee cannot carry the date of his invention back of the date of application in this country, as the holder of a later patent for an invention made here would be permitted to do in order to establish priority.”

From all of the foregoing it must appear, therefore, that the Storch Austrian patent is of no significance whatsoever in this controversy and is no part of the prior art with relation to the Shoemaker patent in suit. These defendants must be restricted to the use of only the Storch

U. S. patent, which has a filing date later than the filing date of the Shoemaker patent and is not any part of the prior art. Section 4923 of the Revised Statutes is absolutely controlling in relation to the point under discussion and various tribunals in the United States, including the Supreme Court, as late as the spring of 1939 have announced that a domestic inventor who applies in this country in good faith, obtains the benefits of Section 4923 of the Revised Statutes, and events in a foreign country prior to the domestic inventor's acts are only of consequence *if the same are identified by a prior patent or printed publication.*

The Storch Disclosures Are Not Anticipatory of the Relied Upon Claims of the Shoemaker Patent in Suit.

The several Storch patents disclose what might be characterized as monstrosities in the wardrobe luggage art. These patents disclose complicated, impractical contraptions and the operation of the same is very problematical. It is clear that Storch contemplated the utilization of a complex lazy tong structure pivotally mounted at the ends of a pair of supporting arms. There is a vague suggestion in the Storch Austrian patent, without an illustration, to the effect that the insert can be so constructed that it consists of only two or more frames. Courts have repeatedly refused to accept as anticipations vague disclosures in foreign patents. See *Warren Bros. Co. vs. City of Owosso*, 166 Fed. 309; and *Carson vs. American Smelting and Refining Co.*, 4 Fed. (2d) 463.

Fig. 4 of the drawings in the Storch United States patent does not illustrate a two-arm frame connected to the outer ends of the members A'. It is merely a fragmentary view of a structure similar to that in Fig. 3 except for a slightly different mode of mounting the inner ends of the

arms A'. With reference to lines 84 to 96 inclusive on Page 2 of Storch's United States specification it will be found that Fig. 4 is merely an illustration of an arrangement to eliminate an automatic projection feature which was present in the principal form of the invention.

Certain exhibits which were offered in evidence by the defendants, over plaintiff's objections, did violence to the actual showings in the Storch patents. We refer to defendants' Exhibits V and W (physical), as well as the illustration in the chart, defendants' Exhibit U (R. Vol. II, p. 690).

Mr. Locke attempted to testify as to these exhibits for the defendants. Exhibits V and W were not made by Mr. Locke nor had he even seen them before the trial. It was admitted that Mr. Wheeler, one of defendants' counsel, brought these models with him from Milwaukee. The models, as well as the sketch, defendants' Exhibit U, were prepared to meet the exigencies of the case and to illustrate what the defendants wished the Storch patents did disclose. Mr. Locke admitted that he had not studied the Storch patents and that he was unable to understand patents and drawings (R. pp. 356, 357, 358 and 360).

The extension device in the Storch patents could never be folded in the manner claimed by the defendants and disclosed in their sketch and models. The Storch patents provide for a different method of folding garments than is provided for in the Schoemaker patent in suit and the accused structures.

This Court has repeatedly refused to modify or reconstruct references in the light of the disclosures of the patent in suit. Reference is made to *Bankers' Utilities Co. vs. Pacific National Bank*, 18 Fed. (2d) 16; and *Butler vs. Burch Plow Co.*, 23 Fed. (2d) 15.

Some of the preceding discussion will show the basis for certain of the points relied upon by the appellant on

appeal (R. pp. 99-101). See particularly points Nos. 8, 10, and 11 which relate to the admission in evidence of exhibits just previously discussed. There is also ample basis for point No. 9 wherein appellant contends that the District Court erred in admitting in evidence the newly constructed Maurice Koch models, defendants' Exhibits K, L, and S.

Conclusion.

The evidence in these consolidated actions clearly shows that the Shoemaker patent in suit No. 1,878,989 discloses and claims new and useful improvements in the hand luggage art. The charge of infringement against both sets of defendants is amply sustained and was recognized by the District Court. These defendants, coming into the field long after the plaintiff and its licensees had created a substantial demand, are not entitled to invade that field to the damage of the plaintiff.

The District Court erred in accepting and applying the submitted evidence relative to the alleged Maurice P. Koch early development.

It is respectfully urged that this Honorable Court reverse the decree of the District Court, with costs to plaintiff-appellant.

Respectfully submitted,

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